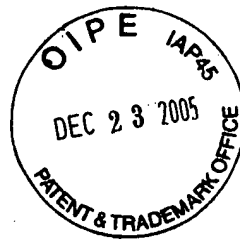


NEIFELD DOCKET NO: CAT/34-SCRO-CCP



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

CONFIRMATION NO. 5917

MICHAEL C. SCROGGIE ET AL.

US APPLICATION NO: 09/505,632

FILING DATE: February 16, 2000

GROUP ART UNIT: 3639

EXAMINER: ROBINSON-BOYCE, A.

TITLE: System and Method for Distributing Information Through Cooperative Communication Network Sites

37 CFR 41.41(b)(2) REPLY BRIEF

COMMISSIONER FOR PATENTS

P.O. BOX 1450

ALEXANDRIA, VA 22313-1450

Sir:

In response to the paper styled as an office action reopening prosecution mailed July 26, 2005 in response to the appeal filed January 19, 2005, which in fact corresponds to a 37 CFR 41.39(b) Examiner's Answer, the applicants file this reply brief.

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**I. 37 CFR 41.37(a)**

This brief sets forth the authorities and arguments on which the appellant will rely to maintain the appeal.

**II. 37 CFR 41.37(b)**

The filing is timely. The paper the USPTO mailed July 26, 2005, stylized as an office action, specifies a three-month response date. Page 2 line 7. However, the examiner was not authorized to mail an office action; only an answer. 37 CFR 41.39(a)(2). Applicant treats that paper as a 37 CFR 41.39(a)(2) answer. Hence, no new notice of appeal or fee is due; and patent term extension from January 19, 2005 continues day for day. However, that paper at page 1 lines 3-5 specifies a 3 month period for reply and that 37 CFR 1.136(a) extensions of time apply. Accordingly, this filing, with its attached extensions of time, is timely.

**III. 37 CFR 41.37(c)(1)(i)**

**A. 37 CFR 41.37(c)(1)(i) Real Party in Interest**

The real party in interest is Catalina Marketing International, Inc., a Delaware corporation, which is wholly owned by Catalina Marketing Corporation, a Delaware corporation.

**B. 37 CFR 41.37(c)(1)(ii) Related Appeals and Interferences**

This appeal was the subject of a prior appeal to the BPAI having BPAI docket 2002-0329. A decision in BPAI docket 2002-0329 was mailed October 27, 2003. A copy of that decision is attached as Attachment 1.

An appeal is pending in related case attorney docket number CAT/34-SCRO-US; application number 08/873,974; not yet docketed at the BPAI. Application number 08/873,974 was the subject of a prior appeal to the BPAI having BPAI docket 2004-1267. A decision in BPAI docket number 2004-1267 was mailed on July 29, 2004. A copy of that decision is attachment 2.

A prior decision in related case BPAI docket number 2004-1267 on request for rehearing was mailed September 30, 2004. A copy of that decision is attachment 3.

An order in the appeal to the CAFC in related case BPAI docket number 2004-1267, CAFC docket number 05-1164, remanding the case to the USPTO, was issued March 9, 2005. A copy of that order is attachment 4.

**C. 37 CFR 41.37(c)(1) (iii) Status of Claims**

Claims 24-31, 36-43 and 48-51 are pending, rejected, and under appeal. Claims 32-35 and 44-47 have been canceled.

**D. 37 CFR 41.37(c)(1) (iv) Status of Amendments**

All amendments have been entered.

**E. 37 CFR 41.37(c)(1)(v) Summary of Claimed Subject Matter**

Claim 24 defines a computer network implemented method, comprising the steps of:

transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer (Fig. 1 item 10; page 8 lines 24-25; Fig. 2 items 2, 10, 30; page 9 lines 18-20; Fig. 1);

in response to said request for manufacturer incentives, transmitting region data from said Web site of said manufacturer over the Internet to a remote Web site (page 8 lines 25-29; Fig. 1);

in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer (page 8 lines 25-28; page 9 lines 20-26; Fig. 2 items 2, 14; 32, 36, 38; Fig. 1); and

transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address (Fig. 2 items 16, 44, 46, 48; Fig. 1).

Claim 28 defines a computer network implemented method, comprising the steps of:

transmitting from a consumer computer over the Internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a

manufacturer (Figure 3 item 50; page 10 lines 4-7; Fig. 1);

in response to receipt of said request at said Web site of said retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site (Figure 3 items 14, 52, 54; Fig. 1);

in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives (page 10 lines 9-11; fig. 3 items 14, 18, 56; Fig. 1); and

in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives (page 10 lines 13-16; Figure 3 items 18, 64, 66, 68; Fig. 1).

Claim 36 defines a computer network implemented system, comprising:

means for transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer (Fig. 1 item 10; page 8 lines 24-25; Fig. 2 items 2, 10, 30; page 9 lines 18-20; Fig. 1);

means for, in response to said request for manufacturer incentives, transmitting region data from said Web site of said manufacturer over the Internet to a remote Web site (page 8 lines 25-29; Fig. 1);

means for, in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer (page 8 lines 25-28; page 9 lines 20-26; Fig. 2 items 2, 14, 32, 36, 38; Fig. 1); and

means for transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address (Fig. 2 items 16, 44, 46, 48; Fig. 1).

Claim 37 defines the system according to claim 36, wherein said means for transmitting from said remote site said list further comprises means for transmitting a link to a Web site of said retailer (page 10 lines 11-12; Fig. 3 items 58, 60; Fig. 1).

Claim 38 defines the system according to claim 36, further comprising means for



determining said at least one manufacturer's incentive and said at least one name and address of a retailer by querying, using said region data, a database from a server of said remote Web site (page 10 lines 7-11; Fig. 3 items 52, 54, 56, 58; Fig. 1).

Claim 39 defines the system according to claim 36, further comprising (page 10 lines 12-16; Fig. 3 items 62, 64, 66, 68; Fig. 1):

means for transmitting from said consumer computer to said Web site of said manufacturer selection data indicating selection of said at least one manufacturer incentive;

means for transmitting from said Web site of said manufacturer to said remote site said selection data;

means for transmitting from said remote site to said Web site of said manufacturer details of the selected at least one manufacturer incentive; and

means for transmitting from said Web site of said manufacturer to said consumer computer said details.

Claim 40 defines a computer network implemented system, comprising:

means for transmitting from a consumer computer over the Internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer (Figure 3 item 50; page 10 lines 4-7; Fig. 1);

means for, in response to receipt of said request at said Web site of said retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site (Figure 3 items 14, 52, 54; Fig. 1);

means for, in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives (page 10 lines 9-11; fig. 3 items 14, 18, 56; Fig. 1); and

means for, in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives (page 10 lines 13-16; Figure 3 items 18, 64, 66, 68; Fig. 1).

Claim 41 defines the system according to claim 40, further comprising: (page 3 lines 3-14; Fig. 1)

means for transmitting a user identification from said Web site of said retailer over the

Internet to said remote Web site in association with said request; and

means for determining manufacturer's incentives to transmit from said remote Web site to said Web site of said retailer based upon said user identification.

Claim 42 defines the system according to claim 40, further comprising means for transmitting from the consumer computer over the Internet to the Web site of the retailer region data (page 9 lines 20-26; Fig. 1).

Claim 48 defines a computer program product for implementing on a network a method, comprising the steps of:

in response to receiving at a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer transmitted from a consumer computer over the Internet, transmitting region data from a Web site of said manufacturer over the Internet to a remote Web site (Fig. 1 item 10; page 8 lines 24-25; Fig. 2 items 2, 10, 30; page 9 lines 18-20; Fig. 1);

in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer (page 3 lines 3-14; Fig. 1); and

transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address (page 10 lines 13-16; Figure 3 items 18, 64, 66, 68; Fig. 1).

Claim 49 defines a computer program product for performing a computer network implemented method, comprising the steps of:

in response to receipt of a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer transmitted from a consumer computer over the Internet to a Web site of a retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site (Figure 3 item 50; page 10 lines 4-7; Fig. 1);

in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives (page 10 lines 9-11; fig. 3 items 14, 18, 56; Fig. 1); and

in response to receipt of said manufacturers incentives at said Web site of said retailer,

transmitting over the Internet to said consumer computer said list of manufacturers incentives (page 10 lines 13-16; Figure 3 items 18, 64, 66, 68; Fig. 1).

Claim 50 defines a computer implemented method comprising performing transactions involving multiple separate entities, including

transmission from a consumer to a retailer website (Figure 3 item 50; page 10 lines 4-7; Fig. 1),

transmission from the retailer website to a remote website (Figure 3 items 14, 52, 54; Fig. 1), and

transmission from the remote website to the retailer website, of a list of manufacturer incentives (page 10 lines 9-11; fig. 3 items 14, 18, 56; Fig. 1).

Claim 51 defines a system comprising structure for performing transactions involving multiple separate entities, including:

means for transmitting from a consumer to a retailer website (Figure 3 item 50; page 10 lines 4-7; Fig. 1),

means for transmitting from the retailer website to a remote website (Figure 3 items 14, 52, 54; Fig. 1), and

means for transmitting from the remote website to the retailer website, of a list of manufacturer incentives (page 10 lines 9-11; fig. 3 items 14, 18, 56; Fig. 1).

**F. 37 CFR 41.37(c)(1)(vi) Grounds for Rejection to be Reviewed on Appeal**

Whether the rejections of claims 50, 51, and 24-27, 36-39, and 48 under 35 USC 112, second paragraph, are improper and should be reversed.

Whether the rejections of claims 24-28, 30, 36-40, 42, 43 and 48-51 under 35 U.S.C. 103(a) as being unpatentable based upon Perkowski (US Patent 6,064,979; hereinafter “Perkowski”) are improper and should be reversed.

Whether the rejections of claims 29 and 41 under 35 U.S.C. 103(a) as being unpatentable based upon Perkowski and Sloane (US Patent 5,918,211; hereinafter “Sloane”) are improper and should be reversed.

Whether the rejections of claims 31 and 43 under 35 U.S.C. 103(a) as being unpatentable

based upon Perkowski and Smolen (US Patent 5,915,243; hereinafter "Smolen") are improper and should be reversed.

**G. 37 CFR 41.37(c)(1)(vii) Argument**

**1. The Rejections Under 35 USC 112 of Claims 50 and 51**

**a. The Examiner's Assertions Regarding Claims 50 and 51**

In support of the rejections of claims 50 and 51 under 35 USC 112, second paragraph, the examiner stated that:

Claims 50 and 51 recites [sic] the limitation "transmission from a consumer to a retailer website", "transmission from the retailer website to a remote website" in claim 50 and "means for transmitting from a consumer to a retailer website", "means for transmitting from the retailer website to a remote website", in claim 51. There is insufficient antecedent basis for this limitation in the claim.

There is no indication as to what is being "transmitted". Correction is required. [Office action mailed July 26, 2005 page 2 lines 14-19.]

**b. The Applicants' Reply**

In reply, the applicants disagree for several reasons. In summary, the claims are clear on their face, clear support exists in the specification defining the meaning of the words and phrases in these claims, and neither the examiner nor the BPAI panel has had any problem understanding the meaning of these claims. In fact, the language used in these claims is the language the BPAI panel used to describe the allowable subject matter in this application in rendering its prior decision.

First, the "transmission" and "means" recitations are clear on their face. The examiner's general allegation that these claims are indefinite provides no reasoning supporting that conclusion, and therefore makes no prima facie case.

Second, there is almost ipsius verbis antecedent basis support for the subject claim

recitations in the specification, and the subject claim recitations are clearly supported by the specification's recitations. See page 3 lines 23-26 and page 11 lines 1-4.

Page 3 lines 23-26 of the specification states that:

The next steps of the method are receiving offer selection data from the consumer through the manufacturer network site, and either transmitting details of the selected offers to the manufacturer network site for use by the consumer, or linking the consumer directly to a selected retailer network site to view the available offers.

Page 11 lines 1-4 of the specification states that:

FIG. 5 shows how manufacturers input update data to the manufacturer offer database 16. In one approach, the manufacturer supplies the data on input forms 90, which are entered at the SMO site 14, as indicated at 92, and transmitted to the databases 16 and 20 by means of an update program 94 executed at the SMO site.

These two recitations clearly disclose that there is a transmission (and a means for transmission) from the retailer Web site to a remote Web site; and a transmission (and a means for transmission) from the retailer Web site to a remote Web site. Moreover, there is sufficient indication as to what is being transmitted, namely, details of the selected offers, as well as data that is input by manufacturers and used to update the manufacturer offer database.

Third, in drafting claims 50 and 51, applicants presented a method claim and a system claim commensurate in scope with and mirroring the wording in the Board of Patent Appeals and Interferences' (panel's) description of the independent claimed inventions in the decision it rendered on the prior appeal in this application. In the decision on appeal mailed October 27, 2003, the panel stated that:

With regard to the rejections under 35 U.S.C. 103, we will not sustain these rejections because each of the independent claims 24, 36, 48, and 49 includes limitations similar to those in claims 28 and 40, i.e., transactions involving multiple separate entities, wherein there is transmission from the a consumer to a retailer website, transmission from the retailer website to a remote website, and transmission from the remote website to the retailer website, of a list of manufacturer incentives. Finally, the retailer web site transmits to the consumer a list of these incentives. [BPAI decision on appeal mailed October 27, 2003 page 9 lines 3-10.]

Since claims 50 and 51 are essentially identical in scope to the panel's description of applicant's claimed invention, they are definite; as definite as the panel's description of allowable subject matter.

Fourth, the examiner's rejections for lack of antecedent basis misapplies the law because anyone reading the claims would know what they defined. For all of the foregoing reasons, the rejections of claims 50 and 51 as indefinite are improper and therefore should be reversed.

c.      **The Examiner's Assertions Regarding Claims 24-27, 36-39,  
and 48**

In support of the rejections of claims 24-27, 36-39, and 48 under 35 USC 112, second paragraph, the examiner stated that:

Claims 24-27, 36-39 and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per independent claims 24, 36, and 48, these claims recite "transmitting region data from said web site of said manufacturer over the Internet **to a remote Web site**", and then "in response to receipt of region data **at said manufacturer's Web site**". This claim language is confusing and indefinite since the region data

is primarily transmitted to a remote site in the first limitation, and then is received at a manufacturer's Web site in the second limitation. Therefore, independent claims 24, 36 and 48, and all claims that depend from them (claims 25-27, and 37-39) are indefinite. Correction is required. [Office action mailed July 26, 2005 page 2 line 20 through page 3 line 6.]

**d. The Applicant's Reply**

In reply, the applicants disagree for several reasons. The examiner's statements indicate the claims are in fact per se definite. In summary, the claims are clear on their face, as apparently admitted by the examiner, clear support exists in the specification defining the meaning of the words and phrases in these claims, and neither the examiner nor the BPAI panel in the prior appeal had any problem understanding the meaning of these claims.

First, the examiner admits that the claims define "region data is primarily transmitted to the remote site in the first limitation" and that region data "is received at a manufacturer's Web site in the second limitation." Thus, the examiner admits that the subject claim recitations are well defined.

Second, there is almost ipsus verbis antecedent basis support for the subject claim recitations in the specification, and the subject claim recitations are clearly supported by the specification. See page 8 lines 25-28 and page 9 lines 20-27.

Page 8 lines 25-28 of the specification states that:

The SMO server 14 delivers a list offers and a list of retailer names and locations to the manufacturer site 10, which makes these lists immediately available to the consumer, through a Web browser on the consumer's personal computer.

Page 9 lines 20-27 of the specification, with emphasis supplied, states that:

At the SMO site 14, the server checks, as indicated in block 32, to

**determine if the consumer's postal (ZIP) code has already been transmitted over the link from the manufacturer site 10.** (At some manufacturer sites, the consumer may be asked to provide a ZIP code when logging in.) If not, the consumer is now asked to enter a ZIP code. If so, this step is bypassed. **Once the ZIP code is obtained, the SMO site 14 queries the database 16 for a list of retailers in that ZIP code having offers from the manufacturer,** as indicated in block 36. **The SMO server 14 then formats a retailer list page, as indicated in block 38, and transmits this list page to the manufacturer site 10.**

The specification clearly discloses that the manufacturer's Web site receives region data and transmits the region data to the remote (SMO) Web site. Based on the region data, the remote Web site transmits information, such as manufacturer's incentives, to the manufacturer's Web site. These two recitations clearly disclose that there is a transmission (and a means for transmission) of region data from the manufacturer's Web site to a remote Web site; and a transmission (and a means for transmission) of region data in response to receipt of region data at the manufacturer's Web site.

Third, the BPAI panel, in the decision on appeal mailed October 27, 2003, stated that:

We agree with appellants that the subject matter of independent claims 28 and 40 is not anticipated by Sloane. These claims clearly call for a transaction involving multiple separate entities, i.e., transmission from a consumer to a retailer website, transmission from the retailer website to a remote website, and transmission from the remote website to the retailer website, of a list of manufacturer incentives. Finally, the retailer website transmits to the consumer a list of these incentives. [BPAI decision on appeal mailed October 27, 2003 page 5 lines 7-15.]

\* \* \*

With regard to the rejections under 35 U.S.C. 103, we will not sustain these rejections because each of the independent claims 24, 36, 48, and 49



includes limitations similar to those in claims 28 and 40, i.e., transactions involving multiple separate entities, wherein there is transmission from the a consumer to a retailer website, transmission from the retailer website to a remote website, and transmission from the remote website to the retailer website, of a list of manufacturer incentives. Finally, the retailer website transmits to the consumer a list of these incentives. [BPAI decision on appeal mailed October 27, 2003 page 9 lines 3-12.]

Thus, the BPAI panel in the prior appeal, and the examiner, had no trouble understanding these claims and expressly construed them.

For all of the foregoing reasons, the rejections of claims 24, 36, and 48, and the claims that depend therefrom, as indefinite, are improper and therefore should be reversed.

**2. The Rejections Under 35 USC 103(a) of Claims 24-28, 30, 36-40, 42, 43, and 48-51 as Being Unpatentable over Perkowski USP 6,064,979**

**a. Perkowski does not Disclose Anything Relevant**

Perkowski is directed to a method of locating on the Internet information about a particular product. Perkowski discloses a networked system including a client computer (which Perkowski calls a "client subsystem"), a server computer (which Perkowski calls "database serving subsystem"), and Web sites of manufacturers. The client computer specifies the product or trademark for the product and Perkowski's server looks up the URL for the product. In Perkowski's system:

During operation, a client subsystem transmits to the database serving subsystem, a request for information which includes the UPN assigned to the consumer product on which product-related information is being sought. *The database serving subsystem automatically compares the UPN against the stored plurality of MINs, and automatically returns to the client subsystem, one or more of URLs symbolically linked to the UPN, if URLs have been symbolically linked*

to the UPN within the database serving subsystem. However, if no URLs have been symbolically linked to the UPN, then the database serving subsystem automatically returns the home-page specifying URL symbolically linked to the MIN contained within the UPN in the request. By virtue of this novel MIN-based search mechanism embodied within the database serving subsystem, client subsystems are automatically provided with the home-page of the manufacturer's World Wide Web (WWW) site in situations where product-information specifying URLs have not yet been symbolically linked with the UPN on any one of the manufacturer's products. [Abstract.]

Perkowski's summary of the invention section contains more detail, but the basic interaction disclosed by Perkowski is as described in Perkowski's abstract. Specifically, Perkowski discloses a system in which the client/consumer transmits a request to the database serving subsystem, and the database serving system looks up information in its local database and returns that information to the client computer. That is a 2-computer process. Perkowski refers to the database serving subsystem as "an Internet Product and Service Directory (IPSD)." Column 4 lines 23-27.

Perkowski discloses that the server and server databases may be split into one server and database that stores/looks up data based upon a product identifier, and one server and database that stores/looks up data based upon a trademark name; the IPSD and IPSI databases and servers, respectively. See the description of Figs 5A and 5B at column 7 lines 34-50. The client computer queries one or both of those databases/servers, depending upon input search data, to locate a URL of a desired product.

Column 18 line 56 is a sub section titled "Operation of the IPSI Finding System and Method" and that section runs from column 18 line 57 to column 20 lines 53. That sub section describes operation of the Perkowski system, wherein no mention is made of three computer systems involved in data transmission. That section confirms that Perkowski's system involves only transmission between a server and the consumer/client computer. It states in the most pertinent part at that "In response to such data entry operations, a list of URLs organized

according to the information subfield classifications set forth in FIG. 2A2 are displayed on Client System C.sub.a making the request of the IPSD Server."

Perkowski's disclosure relating to finding product incentives includes the following.

First, in the summary of the invention section, a goal of locating product incentives:

Another object of the present invention is to provide such a product information finding system, wherein the URLs symbolically linked to each registered product in the IPSD Servers thereof are categorized as primarily relating to Product Advertisements, Product Specifications, Product Updates, Product Distributors, Product Warranty/Service, and/or Product Incentives (e.g. rebates, discounts and/or coupons), and that such URL categories are graphically displayed to the requester by way of easy-to-read display screens during URL selection and Web-site connection. [Column 4 lines 43-54.]

Second, a database storing URL locations of product incentives, as outlined in the description of Fig. 2A:

In order to provide the requester greater control over what information is actually displayed on its Client System, the URL Information Field of the IPSI Database shown in FIG. 2A1 contains a number of information subfields. As shown in FIG. 2A2, these information subfields comprise: a Product Advertisement Information Field for storing information representative of URLs pointing to information on the Internet relating to advertising and/or promotion of the product; a Product Specification (Description) Information Field for storing information representative of URLs pointing to information on the Internet relating to specifications on the product; a Product Update Information Field for storing information representative of URLs pointing to information on the Internet relating to product updates, recalls, notices, etc; a Product Distributor Information Field for storing information representative of URLs pointing to information on

the Internet relating to distribution, sale and/or ordering of the product; a Product Warranty/Servicing Information Field for storing information representative of URLs pointing to information on the Internet relating to warranty, extended warranty offerings, servicing and maintenance of the product; a Product Incentive Information Field (e.g. rebates, discounts and/or coupons) for *storing information representative of URLs pointing to information on the Internet relating to rebates, discounts and sales on the product ...* [Column 12 lines 20-45; italics added for emphasis.]

Thus, Perkowski provides to a consumer the URL where incentives information for a product specified by the consumer is stored, by looking up that product's record in Perkowski's database server.

**b. Perkowski Fails to Disclose all of the Significant Limitations of the Independent Claims**

Claim 24 recites:

24. A computer network implemented method, comprising the steps of:  
transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer;

in response to said request for manufacturer incentives, transmitting region data from said Web site of said manufacturer over the Internet to a remote Web site;

in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer;  
and

transmitting from said Web site of said manufacturer over the Internet to

said consumer computer said at least one manufacturer incentive and said at least one name and address.

Perkowski does not disclose "transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request for manufacturer incentives". Perkowski's servers are not Web sites of manufacturers. Perkowski's users do not request incentives from Perkowski's system; they request information about incentives.

Perkowski does not disclose "transmitting region data from said Web site of said manufacturer over the Internet to a remote Web site." Moreover, Perkowski does not disclose performing this step "in response to said request for manufacturer incentives."

Perkowski does not disclose "transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer." Moreover, Perkowski does not disclose performing this step "in response to receipt of region data at said manufacturer's Web site."

Finally, Perkowski does not disclose "transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address."

Claim 28 recites:

28. A computer network implemented method, comprising the steps of:  
transmitting from a consumer computer over the Internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer;

in response to receipt of said request at said Web site of said retailer,  
transmitting said request from said Web site of said retailer over the Internet to a remote Web site;

in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives; and

in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives.

Perkowski does not disclose "transmitting from a consumer computer over the Internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer." Moreover, Perkowski does not disclose responding to that request by "transmitting said request from said Web site of said retailer over the Internet to a remote Web site." Similarly, Perkowski does not disclose the remaining steps defined by claim 28.

Similarly, Perkowski does not disclose the corresponding means recitations of independent claims 36 and 40 and program product limitations of independent claims 48, 49, and system and method claims 50 and 51.

The examiner corresponds certain disclosure in Perkowski to the foregoing claim limitations asserting that the claim recitations noted above read on those disclosures in Perkowski. The examiner is wrong, as is noted below.

**c. The Examiner's Assertions Regarding Independent Claims 24, 36, 48, and 49**

In support of the rejections of claims 24, 36, 48, and 49 under 35 USC 103(a) based upon Perkowski, the examiner stated that:

As per claim 24, 36, 48, 49, Perkowski discloses:

transmitting from a consumer computer over the Internet to a Web site of a manufacturer/retailer a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer/means for transmitting from a consumer computer over the Internet to a Web site of a manufacturer/retailer a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer, (Abstract, lines 11-15, client subsystem transmits a

request for manufacturer products, and the client subsystem is provided with the homepage of the manufacturer's World Wide Web site as shown in the abstract, lines 26-27, w/ col. 10, lines 14-19, shows client system is maintained by consumers at retail outlets, in this case the consumer computer is represented by a kiosk, and the consumer makes a request over the Internet [col. 9, lines 60-63] at the retail location);

in response/means for, in response to receipt of a request for manufacturer incentives, transmitting region data from said Web site of said manufacturer over the Internet to a remote Web site/in response to receipt of a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer transmitted from a consumer computer over the Internet, transmitting region data from a Web site of said manufacturer over the Internet to a remote Web site/in response to receiving at a web site of a manufacturer, a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer transmitted from a consumer computer over the Internet, transmitting region data from a Web site of said manufacturer over the Internet to a remote Web site/in response to receipt of a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer transmitted from a consumer computer over the Internet to a Web site of a retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site, (Col. 4, lines 63-col. 5, line 3, shows request going to IPSD server, where region data such as Web site addresses for the manufacturer is shown to be transmitted to the IPSD server by way of registration as shown in col. 5, lines 52-59, w/col. 6, lines 18-24, shows Internet product and service information is carried out by the IPSD Web-site);

in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer/means for transmitting from said remote Web site to said Web site of said

manufacturer at least one manufacturer incentive and at least one name and address of a retailer/ in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives, (Col. 5, lines 1-8, shows URLs accessed from the IPSD server and displayed on the display screen of the internet browser, w/ col. 4 lines 44-51, shows that URL categories include Product Incentives, w/ col. 10, lines 54-56 and col. 11, lines 4-8, shows company name and company e-mail address are some of the information stored in the IPSD server and it is therefore the same type of information that is transmitted by the IPSD Web site)

transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address/ in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives, (Col. 5, lines 6-8, shows subsequent URL selection [done by consumer] of information transmitted by the IPSD Web site, which includes company name and company e-mail address as discussed above).

Perkowski does not specifically disclose that the request goes to the Web site of the retailer, however, this limitation is obvious since client systems are maintained by the consumer at retail outlets, and since the consumer makes a request over the Internet by way of the retail outlet, the retailer's Web page is therefore being utilized.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to direct a request to the Web site of the retailer with the motivation of allowing a consumer to easily interact with the product request environment since the retailer is more accessible to the consumer than the manufacturer. [Office action mailed July 26, 2005 page 3 line 18 through page 6 line 12.]



In reply, the applicant submits that the examiner's reliance on Perkowski, is misplaced. Perkowski does not disclose several limitations defined by claims 24, 36, 48, and 49, as noted above. Moreover, the examiner's errors are explained below.

- d. **Contrary to the Examiner's Assertion, Perkowski does not Disclose "transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer"**

In support of the rejections of claims 24, 36, 48, and 49 under 35 USC 103(a) based upon Perkowski, the examiner stated that:

As per claim 24, 36, 48, 49, Perkowski discloses:

transmitting from a consumer computer over the Internet to a Web site of a manufacturer/retailer a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer/means for transmitting from a consumer computer over the Internet to a Web site of a manufacturer/retailer a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer, (Abstract, lines 11-15, client subsystem transmits a request for manufacturer products, and the client subsystem is provided with the homepage of the manufacturer's World Wide Web site as shown in the abstract, lines 26-27, w/ col. 10, lines 14-19, shows client system is maintained by consumers at retail outlets, in this case the consumer computer is represented by a kiosk, and the consumer makes a request over the Internet [col. 9, lines 60-63] at the retail location); [Office action mailed July 26, 2005 page 3 line 18 through page 4 line 6.]

The examiner's assertion that Perkowski abstract lines 11-15, 26-27, column 10 lines 14-19, and column 9 lines 60-63 disclose transmission from a consumer computer over the Internet

to a Web site of a manufacturer is incorrect. Instead, the examiner corresponds Perkowski's data server system to the claimed "Web site of a manufacturer." Specifically, in the office action mailed July 26, 2005, the examiner relied upon:

During operation, a client subsystem transmits to the database serving subsystem, a request for information which includes the UPN assigned to the consumer product on which product-related information is being sought.

[Abstract lines 11-15.]

\* \* \*

... client subsystems are automatically provided with the home-page of the manufacturer's World Wide Web (WWW) site in ... [Abstract lines 26-27.]

\* \* \*

Typically, each Client System 5 will be maintained by consumers (and/or) potential consumers of products and/or services, about which information can be found on the Internet. It is understood, however, that a Client System can be realized in the form of computer-based kiosks located in supermarkets, department stores, retail outlets, or other ... [Column 10 lines 14-19.]

\* \* \*

... an Internet browser program (e.g. Netscape, Internet Explorer, Mosaic, etc.) which includes Internet networking software that supports the TCP/IP networking protocol, and provides a GUI-based Web browser interface. [Column 9 lines 60-63.]

From the foregoing, it appears that the examiner corresponds Perkowski's client subsystem corresponds to a consumer computer. Thus, Perkowski discloses only transmissions between the client computer and Perkowski's database server of address data. A two computer interaction.

The examiner's implied assertion that Perkowski's IPSD server is a Web server of a manufacturer is incorrect. The IPSD server is not related to a particular manufacturer.

Perkowski column 8 lines 45-60 states that:

As shown, the on-screen IPSI Web-site Finder icon functions as an "IPSI Web-site Finder" Button 11 for instantly connecting the Client System to the IPSI Web-site (i.e., on each IPSD Server) and carrying out the Internet Product and Service Information (IPSI) finding method of the present invention. Upon selecting this button (e.g. by a clicking of the mouse), the user is automatically connected to the IPSI Web-site (supported on each IPSD Server), at whose "home page" appears the IPSI Finder and UPSN Search buttons described above appear and functionalities represented thereby. The URL for the home page of the IPSI Web-site should be selected with marketing considerations in mind, for example, "http://www.ipf.com" or "http://www.ipsi.com" similar in form with the URLs of other information search-engines and directories currently available on the Internet.

Perkowski discloses an IPSD server supporting an "IPSI Web-site Finder" button 11. Perkowski discloses that "the user selects the 'UPSN Search' button on the GUI-based browser display screen." Once this button is clicked by a mouse, the user is connected to the IPSI Web site. In response to a trademark, servicemark, and/or company name, the "Client System requests the IPSD Server S(b) to provide each registered USPN(i) stored in the IPSI Registrant Database, and if so, then also its URL, to the Client System." Perkowski column 15 lines 11-18.

Perkowski discloses that, in response to the consumer's query, the Web pages that are served from the IPSD server and the IPSI server to the Internet browser display contain information that associate products registered with the IPSI registrant database, with a URL. The client computer then requests the IPSI server, identified by the user-selected URL, to provide the product or service information. Perkowski column lines 19-36. However, the Web pages that are served from the IPSD server and the IPSI servers are not served from a manufacturer Web site. As Perkowski does not disclose transmitting from a consumer computer to the Web site of a manufacturer, Perkowski cannot disclose transmitting a request for new incentives from a Web

site of a Manufacturer over the Internet to a remote Web site.

Thus, Perkowski does not disclose “transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer,” as recited by claim 24 and defined by claim 36.

- e. **Contrary to the Examiner’s Assertion, Perkowski does not Disclose “in response to said request for manufacturer incentives, transmitting region data from said Web site of said Manufacturer over the Internet to a remote Web site”**

In support of the rejections of claims 24, 36, 48, and 49 under 35 USC 103(a) based upon Perkowski, the examiner stated that:

in response/means for, in response to receipt of a request for manufacturer incentives, transmitting region data from said Web site of said manufacturer over the Internet to a remote Web site/in response to receipt of a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer transmitted from a consumer computer over the Internet, transmitting region data from a Web site of said manufacturer over the Internet to a remote Web site/in response to receiving at a web site of a manufacturer, a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer transmitted from a consumer computer over the Internet, transmitting region data from a Web site of said manufacturer over the Internet to a remote Web site/in response to receipt of a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer transmitted from a consumer computer over the Internet to a Web site of a retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site, (Col. 4, lines 63-col. 5, line 3, shows request going to IPSD server, where region data such as Web site addresses for the manufacturer is

shown to be transmitted to the IPSD server by way of registration as shown in col. 5, lines 52-59, w/col. 6, lines 18-24, shows Internet product and service information is carried out by the IPSD Web-site); [Office action mailed July 26, 2005 page 4 lines 7-24.]

The examiner's assertion that Perkowski column 4 line 63 through column 5 line 3 discloses "in response to said request for manufacturer incentives, transmitting region data from said Web site of said manufacturer over the Internet to a remote Web site," as recited by claim 24 and defined by claims 36 and 48, is incorrect.

Perkowski does not disclose utilizing region data, much less transmitting region data to a remote Web site. The examiner's assertion that the claimed region data reads on a Web site address, at office action mailed July 26, 2005 page 4 line 21, is incorrect. Moreover, the examiner admits that fact by also asserting in different context that region data means postal data:

It would have been obvious to one of ordinary skill in the art for the region data to be postal code data in order to determine the location of the retailer versus the location of the location of the user for incentive transmittal purposes. [Office action mailed July 26, 2005 page 13 lines 13-15; emphasis supplied.]

In fact, page 4 lines 14-19 of the specification defines region data to mean geographic region, clearly excluding Web site addresses from that meaning, stating that:

In accordance with another aspect of the invention, the method further includes receiving the consumer's postal code; and using the consumer's postal code to customize the information provided to the consumer's local geographical area. The postal code provides a key to access internal or external sources of geo-demographic data, from which targeted information can be generated for transmission to the consumer.

In other words, the application defines region data to mean geographic data. Perkowski's Web site address is not "region data." Perkowski does not imply or suggest transmitting region data.

For the reasons submitted above, Perkowski does not disclose "in response to said request for manufacturer incentives, transmitting region data from said Web site of said manufacturer over the Internet to a remote Web site;" as recited by claim 24 and defined by claims 36 and 48.

**f. Contrary to the Examiner's Assertion, Perkowski does not  
Disclose "in response to" the Receipt of a Request for a  
Manufacturer Incentive**

In support of the rejections of claims 24, 36, 48, and 49 under 35 USC 103(a) based upon Perkowski, the examiner stated that:

in response/means for, in response to receipt of a request for manufacturer incentives, transmitting region data from said Web site of said manufacturer over the Internet to a remote Web site/in response to receipt of a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer transmitted from a consumer computer over the Internet, transmitting region data from a Web site of said manufacturer over the Internet to a remote Web site/in response to receiving at a web site of a manufacturer, a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer transmitted from a consumer computer over the Internet, transmitting region data from a Web site of said manufacturer over the Internet to a remote Web site/in response to receipt of a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer transmitted from a consumer computer over the Internet to a Web site of a retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site, (Col. 4, lines 63-col. 5, line 3, shows request going to IPSP server, where region data such as Web site addresses for the manufacturer is

shown to be transmitted to the IPSD server by way of registration as shown in col. 5, lines 52-59, w/col. 6, lines 18-24, shows Internet product and service information is carried out by the IPSD Web-site); [Office action mailed July 26, 2005 page 4 lines 7-24.]

Clearly, nothing in Perkowski corresponds to the action "in response to" the receipt of a request for a manufacturer incentive, as defined by independent claims 24, 28, 36, 40, 48, and 49.

- g. **Contrary to the Examiner's Assertion, Perkowski does not Disclose "in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer"**

In support of the rejections of claims 24, 36, 48, and 49 under 35 USC 103(a) based upon Perkowski, the examiner stated that:

in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer/means for transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer/ in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives, (Col. 5, lines 1-8, shows URLs accessed from the IPSD server and displayed on the display screen of the internet browser, w/ col. 4 lines 44-51, shows that URL categories include Product Incentives, w/ col. 10, lines 54-56 and col. 11, lines 4-8, shows company name and company e-mail address are some of the information stored in the IPSD server and it is

therefore the same type of information that is transmitted by the IPSD Web site)  
[Office action mailed July 26, 2005 page 5 lines 3-15.]

The examiner's assertions that Perkowski column 5 lines 1-8, column 4 lines 44-51, column 10 lines 54-56, and column 11 lines 4-8 disclose (1) acting in response to receipt of region data at a manufacturer's site and (2) transmitting from a remote web site to a manufacturer Web site are incorrect. Instead, the passages in Perkowski disclose (1) a client querying the IPSD servers to locate a URL of a desired product and (2) database information fields which contain information regarding manufacturers and service providers. Specifically, in the office action mailed July 26, 2005, the examiner relied upon:

... makes, sells or distributes the particular product, and (ii) the corresponding UPN (i.e., UPC number or EPC number) registered with the IPSD Servers is displayed to the user for acceptance, whereupon the Internet information resource locators (URLs) are automatically accessed from the IPSD Servers and displayed on the display screen of the Internet browser for subsequent URL selection and Web-site connection. [Column 5 lines 1-8.]

\* \* \*

Another object of the present invention is to provide such a product information finding system, wherein the URLs symbolically linked to each registered product in the IPSD Servers thereof are categorized as primarily relating to Product Advertisements, Product Specifications, Product Updates, Product Distributors, Product Warranty/Service, and/or Product Incentives (e.g. rebates, discounts and/or coupons), and that such URL categories are graphically displayed to the requester by way of easy-to-read display screens during URL selection and Web-site connection . . . [Column 4 lines 44-53.]

\* \* \*

... a Company Name Information Field for storing information (e.g. numeric or alphanumeric string) representative of the name of the company



making, selling . . . [Column 10 lines 54-56.]

\* \* \*

. . . an E-mail Address Information Field for storing information (e.g. numeric or alphanumeric string) representative of the e-mail address of the corresponding company (e.g. manufacturer) on the Internet; [Column 11 lines 4-8.]

As stated above, Perkowski does not imply or suggest transmitting region data. Therefore, Perkowski does not disclose receipt of region data at a manufacturer's Web site or acting in response to receipt of region data at a manufacturer's Web site.

Moreover, Perkowski does not disclose transmitting from a remote Web site to the Web site of a manufacturer. The examiner's implied assertion in the office action mailed July 26, 2005 at page 5 lines 10-11 that the display screen of the Internet browser server is a manufacturer Web site is clearly incorrect. Perkowski discloses a system in which the consumer transmits a request to the database serving subsystem (either the IPSD or IPSI), and the database serving system looks up information in its local database and returns the URL of a desired product to the client computer. That is a 2-computer process involving only transmission between a consumer computer and a server.

Perkowski column 4 lines 44-53 discloses categorizing URLs by product incentives, but Perkowski does not disclose transmitting product incentives. Perkowski column 10 lines 54-56 discloses an information field containing the name of a retailer, but Perkowski does not disclose the address of a retailer. In the office action mailed July 26, 2005 at page 5 lines 12-15, the examiner argues that Perkowski's disclose email address of a retailer discloses the subject invention's disclosure of a retailer's address. Page 4 lines 14-19 of the specification (copied *supra*) defines region data to mean geographic region, clearly excluding email addresses from that meaning. Therefore, Perkowski does not disclose a transmission from a remote Web site to the Web site of a manufacturer containing a manufacturer incentive and a name and address of a retailer.

Thus, Perkowski does not disclose "in response to receipt of region data at said

manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer," as recited by claims 24 and 48, and defined by claim 36.

- h. **Contrary to the Examiner's Assertion, Perkowski does not Disclose "transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one [retail store] name and address"**

In support of the rejections of claims 24, 36, 48, and 49 under 35 USC 103(a) based upon Perkowski, the examiner stated that:

transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address/ in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives, (Col. 5, lines 6-8, shows subsequent URL selection [done by consumer] of information transmitted by the IPSD Web site, which includes company name and company e-mail address as discussed above). [Office action mailed July 26, 2005 page 5 lines 16-23.]

The examiner's assertion that Perkowski column 5 lines 6-8 disclose a transmission from the Web site of a manufacturer to a consumer containing a manufacturer incentive, a retailer name, and a retailer address is incorrect. Specifically, in the office action mailed July 26, 2005, the examiner relied upon:

... Servers and displayed on the display screen of the Internet browser for subsequent URL selection and Web-site connection. [Perkowski column 5 lines 6-8.]

This passage discloses that the IPSP server displays URLs associated with a requested product on the Internet browser of the consumer who had requested the information. As stated above, Perkowski discloses a 2-computer process involving only transmission between a consumer computer and a server. Perkowski does not disclose transmitting from the Web site of a manufacturer to a consumer computer. As also stated above, Perkowski is silent regarding retail store names and addresses.

Therefore, Perkowski does not disclose “transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one [retail store] name and address” as recited in claims 24 and 48 with interpolation supplied and defined in claim 36.

- i. **Contrary to the Examiner’s Assertion, the Request does not go to the Web Site of the Retailer**
  - i. **Contrary to the Examiner’s Assertion, Perkowski does not Disclose a Transmission Involving a Retailer Web Site**

In support of the rejections of claims 24, 36, 48, and 49 under 35 USC 103(a) based upon Perkowski, the examiner stated that:

... col. 10, lines 14-19 shows client system is maintained by consumers at retail outlets, in this case the consumer computer is represented by a kiosk, and the consumer makes a request over the Internet [col. 9, lines 60-63] at the retail location); [Office action mailed July 26, 2005 page 4 lines 3-6.]

Perkowski column 10 lines 14-19 states that:

Typically, each Client System 5 will be maintained by consumers (and/or) potential consumers of products and/or services, about which information can be found on the Internet. It is understood, however, that a Client System can be

realized in the form of computer-based kiosks located in supermarkets, department stores, retail outlets, or other . . .

In reply, the passage discloses that a client system can be located in a retail outlet. Neither this passage, nor any part of Perkowski, discloses a transmission involving the Web site of a retailer. Moreover, the examiner's possibly assumed conclusion that Perkowski's web site is a retailer web site because it may be hosted by a retailer's computer is incorrect, because Perkowski web site provides links to other (and clearly competing) retailer web sites and that functionality is inconsistent.

For these reasons, Perkowski also does not disclose (1) "in response to receipt of a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer transmitted from a consumer computer over the Internet to a Web site of a retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site;" (2) "in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives;" or (3) "in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives," as recited in claim 49.

**ii. Contrary to the Examiner's Assertion, it is not Obvious that Perkowski Discloses that a Request goes to the Web Site of a Retailer**

The examiner asserted that it was obvious that Perkowski discloses that a request goes to the Web site of a retailer. In the office action mailed July 26, 2005 at page 6 lines 3-12, the examiner stated that:

Perkowski does not specifically disclose that the request goes to the Web site of the retailer, however, this limitation is obvious since client systems are maintained by the consumer at retail outlets, and since the consumer makes a

request over the Internet by way of the retail outlet, the retailer's Web page is therefore being utilized.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to direct a request to the Web site of the retailer with the motivation of allowing a consumer to easily interact with the product request environment since the retailer is more accessible to the consumer than the manufacturer.

In reply, the statement "this limitation is obvious since client systems are maintained by the consumer at retail outlets, and since the consumer makes a request over the Internet by way of the retail outlet, the retailer's Web page is therefore being utilized" contains non-sequiturs and factually erroneous conclusions. First, "client systems are [not] maintained" by consumers at "retail outlets." The applicant does not understand that statement. Second, Perkowski does not disclose that "the consumer makes a request over the Internet by way of the retail outlet." Third, assuming the consumer uses a retailer's computer to access the Internet, that does not mean that the "retailer's Web page is therefore being utilized."

Finally, neither the relevance nor legal correctness of the paragraph beginning "It would have been obvious . . ." is apparent. Therefore, the examiner's assertion that it was obvious that Perkowski discloses that a request goes to the Web site of a retailer is incorrect.

For all of the reasons presented above, the rejections of claims 24, 36, 48, and 49 are improper and should be reversed.

**j. Contrary to the Examiner's Assertion, Perkowski does not  
Disclose the Limitations Defined by Claims 25 and 37**

In support of the rejections of claims 25 and 37 under 35 USC 103(a), the examiner stated that:

As per claim 25, 37, Perkowski discloses:  
wherein said step of transmitting from said remote site said list further

comprises transmitting a link to a Web site of said retailer/wherein said means for transmitting from said remote site said list further comprises means for transmitting a link...(Col. 4, lines 45-52, shows URLs are symbolically linked to each registered product). [Office action mailed July 26, 2005 page 6 lines 13-18.]

In reply, the applicant submits that claims 25 and 37 depend from claims 24 and 36, respectively. Therefore, the rejections of claims 25 and 37 are improper and should be reversed for the same reasons as for claims 24 and 36.

**k. Contrary to the Examiner's Assertion, Perkowski does not Disclose the Limitations Defined by Claims 26, 30, 38, and 42**

In support of the rejections of claims 26, 30, 38, and 42 under 35 USC 103(a), the examiner stated that:

As per claims 26, 30, 38, 42, Perkowski discloses:

determining said at least one manufacturer's incentive and said at least one name and address of a retailer by querying, using said region data, a database from a server of said remote Web site/means for determining . . .transmitting from the consumer computer over the Internet to the Web site of the retailer region data/means for transmitting ...(Col. 1, lines 54-64, shows It is common to use search by location of the seller's site via search engines to determine that seller's product information, where it is shown that product information includes company name and company email address since this is some of the information stored in the IPSD server and it is therefore the same type of information that is transmitted by the IPSD Web site). [Office action mailed July 26, 2005 page 6 line 19 through page 7 line 6.]

In rejecting claims 26, 30, 38, and 42, the examiner relies on the following passage from Perkowski:

In order to acquire product information through the seller's WWW site, the inquirer must first determine the location of its WWW site (i.e. Internet address) which oftentimes can involve using Internet Search engines such as Yahoo.RTM., AltaVista.TM., WebCrawler.TM., Lycos.TM., Excite.TM., or the like. This can be a very time consuming process and may lead to a dead end. Upon obtaining the Internet address one must then review the home page of the company's Web-site in order to find where, if at all, information about a particular product resides on the Website. [Column 1 lines 54-64.]

In reply, the applicant points out that an Internet search engine pertains to a virtual location, which is not relevant to region data. Region data pertains to a geographical location. As stated above, Perkowski does not disclose utilizing or transmitting region data. Thus, Perkowski does not disclose “determining said at least one manufacturer's incentive and said at least one name and address of a retailer by querying, using said region data, a database from a server of said remote Web site,” as recited by claim 26 and defined by claim 38; and Perkowski does not disclose “transmitting from the consumer computer over the Internet to the Web site of the retailer region data,” as recited by claim 30 and defined by claim 42.

For the reasons presented above, the rejections of claims 26, 30, 38, and 42 are improper and should be reversed. Claims 26, 30, 38, and 42 depend from claims 24, 28, 36, and 40, respectively. Therefore, the rejections of claims 26, 30, 38, and 42 are improper and should be reversed for the same reasons as for claims 24, 28, 36, and 40.

**1. Contrary to the Examiner's Assertion, Perkowski does not  
Disclose the Limitations Defined by Claims 27 and 39**

In support of the rejections of claims 27 and 39 under 35 USC 103(a), the examiner stated that:

As per claim 27, 39, Perkowski discloses:  
transmitting from said consumer computer to said Web site of said

manufacturer selection data indicating selection of said at least one manufacturer incentive/means for transmitting . . . (Col. 15, lines 19-44, shows that a consumer makes a request at a client subsystem that is physically hosted at the retailer by way of a three-field browser framework which includes search button);

transmitting from said Web site of said manufacturer to said remote site said selection data/means for transmitting from said Web site . . . (Col. 15, lines 37-40, IPI finding an serving subsystem is the remote site);.

transmitting from said Web site of said manufacturer to said consumer computer details/means for transmitting from said Web site of said manufacturer, (Col. 12, lines 16-20, shows transfer of consumer product related information between the Remote Client Computer and the Web-Based Document Server, in this case, the consumer computer is shown by the Client Computer, and the remote website is shown by the Web-Based Document Server since it is remote to the Remote Client, w/ Col. 11, lines 37-40, shows that a central UPC/URL database Subsystem serves the consumer product information to consumers, where the name of the product's manufacturer and URL specifying the location of information resources are served to remote retailers and consumers and is included in consumer product information, w/ Col. 13, lines 2-9, where it is also shown that the Web based document server transfers UPC/URLs to the IPD servers, and therefore works in conjunction with the UPC/URL database to serve the consumer product information to consumers, w/ Col. 6, lines 50-58, the list is shown by categorizing and graphically displaying product information which also includes Product Incentives, w/ Col. 11, lines 34-45, shows the name of the product's manufacturer and URL specifying the location of information resources are served to remote retailers and consumers and is included in consumer product information, w/ Col. 13, lines 2-9, where it is also shown that the Web based document server transfers UPCIURLs to the IPD servers, and therefore works in conjunction with the UPC/URL database to serve the consumer product information to consumers, w/ Col. 6, lines 50-58, the list is shown by categorizing



and graphically displaying product information which also includes Product Incentives, w/ Col. 11, lines 34-45, shows the name of the product's manufacturer and URL specifying the location of information resources are served to remote retailers and consumers).

The following is obvious with Perkowski:

transmitting from said remote site to said Web site of said manufacturer details of the selected at least one manufacturer incentive/means for transmitting from said remote site. ...(Col. 15, lines 37-40, obvious that details are transmitted to the manufacturer since the browser ultimately displays Web pages served from the IPD server and associated with the Search mode);

It would have been obvious to one of ordinary skill in the art to transmit from said remote site to said Web site of said manufacturer details of the selected at least one manufacturer incentive with the motivation ensuring that significant details of manufacturer selection data are sent to the correct location. [Office action mailed July 26, 2005 page 7 line 7 through page 9 line 8.]

In rejecting claims 27 and 39, the examiner relied on the following passages from Perkowski:

At Block B in FIG. 4B, the IPSD Server S.sub.b analyses the IPSI Registrant Database shown in FIG. 2A1 to determine whether or not a symbolically linked UPSN.sub.i has been registered with a TM.sub.i (or SM.sub.i) and/or a company name CN.sub.i that have been provided as input to the IPSD Server S.sub.b by way of the browser display screen. If so, then the IPSD Server sends to the Client System C.sub.a, the URL.sub.i that is symbolically linked to the registered UPSN.sub.i. If not, then the IPSD records in the URL-request in the Non-IPSI Registrant Database shown in FIG. 2B for future registration-request operations related to the T/SM.sub.i sent by the Client System.

At Block C in FIG. 4B, the Client System C.sub.a receives the URL.sub.i

from the IPSD Server. Then, in response to a URL selection query based on the contents of the information subfields shown in FIG. 2A2 and displayed on the screen of the Client System C.sub.a, the Client System requests the IPSI Server, identified by the user selected URL.sub.i, to provide the product or service information. Having accessed and displayed such product or service related information at the Client System, the user can review the information at the specified URL.sub.i, acquire knowledge about the product or service, and may, if the option is provided at the URL-specified Web-site, purchase the product or procure (i.e. contract for) the service by way of an on-screen electronic commercial transaction, as described hereinabove. [Column 15 lines 19-44.]

\* \* \*

... and (iii) a one digit modulo check digit (mathematically calculated) and added to each UPC number to ensure that the code has been read correctly by the bar code reader. [Column 12 lines 16-20.]

\* \* \*

... contemplates the need and utility of widespread assignment of UPC (or similar) numbers to particular services (as well as the imprinting of UPC (or similar) symbols on printed service brochures and advertisements. Notably, assigning UPC (or like) numbers to particular services, and labeling printed and graphical brochures and advertisements with such universal numbers, will provide a number of new opportunities hitherto unavailable. [Column 13 lines 2-9.]

\* \* \*

FIG. 2A2 is a schematic representation of the information subfield structure of the URL Information Field of the IPSD Database of FIG. 2A1, showing the Product Advertisement Information Field, the Product Specification (Description) Information Field, the Product Update Information Field, the Product Distributor Information Field, the Product Warranty/Service Information Field, the Product Incentive Information Field thereof, the Product Review Information Field, and Miscellaneous Information Field; [Column 6 lines

50-58.]

\* \* \*

... identifying who owns the server or where it is located; a Path Name, such as "Products/Computers/", indicating a path to the destination information file on the identified Server; and a Resource Name (including file extension, e.g. ".html"), such as "aptiva.html", identifying the actual named information file that contains existing information resource specified by the URL.

As used herein, as well as in the claims to Invention, the term "registered" and the variants thereof shall be understood to mean listed or having an entry within a database. Such listing or entry can be achieved in a variety of ways including, but not limited to the following: [Column 11 lines 34-45.]

In reply, the applicant submits that the examiner's cite to Perkowski column 15 lines 37-40 refers to product or service information displayed at the client system, which as discussed above, is not a manufacturer Web site. Therefore, "transmitting from said remote site to said Web site of said manufacturer details of the selected at least one manufacturer incentive/means for transmitting from said remote site" limitations would not have been obvious in view of Perkowski.

Claims 27 and 39 depend from claims 24 and 36, respectively. Therefore, the rejections of claims 27 and 39 are improper and should be reversed for the same reasons as for claims 24 and 36.

m. **Contrary to the Examiner's Assertion, Perkowski does not Disclose the Limitations Defined by Independent Claims 28 and 40**

In support of the rejections of claims 28 and 40 under 35 USC 103(a), the examiner stated that:

As per claim 28, 40, Perkowski discloses:

transmitting from a consumer computer over the internet to a . . . retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer/means for transmitting from a consumer computer over the internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacture/transmission from the a consumer to a retailer website, (Abstract, lines 11-15, client subsystem transmits a request for manufacturer products, w/ col. 10, lines 14-19, shows client system is maintained by consumers at retail outlets, in this case the consumer computer is represented by a kiosk, and the consumer makes a request over the Internet [col. 9, lines 60-631 at the retail location);

in response to receipt of said request at . . . said retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site/means for transmitting said request from said Web site of said retailer over the Internet to a remote Web site, (Col. 4, lines 63-col. 5, line 3, shows request going to IPSD server, w/ col. 6, lines 18-24, shows Internet product and service information is carried out by the IPSD Web-site);

in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said . . . retailer a list of manufacturer incentives/means for transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives; (Col. 5, lines 1-8, shows URLs accessed from the IPSD server and displayed on the display screed of the internet browser, w/ col. 4 lines 44-51, shows that URL categories indude Product Incentives).

In response to receipt of said manufacturers incentives at said . . . retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives/means for transmitting over the Internet to. said consumer computer said list of manufacturers incentives, (Col. 5, lines 6-8, shows subsequent URL selection [done by consumer]).

Perkowski does not specifically disclose that the request goes to the Web site of the retailer, however, this limitation is obvious since client systems are maintained by the consumer at retail outlets, and since the consumer makes a request over the Internet by way of the retail outlet, the retailer's Web page is therefore being utilized.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to direct a request to the Web site of the retailer with the motivation of allowing a consumer to easily interact with the product request environment since the retailer is more accessible to the consumer than the manufacturer. [Office action mailed July 26, 2005 page 9 line 9 through page 10 line 24.]

In reply, the applicant submits that the examiner's reliance on Perkowski, is misplaced. Perkowski does not disclose several limitations defined by claims 28 and 40.

- n. **Contrary to the Examiner's Assertion, Perkowski does not Disclose "transmitting from a consumer computer over the Internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer"**

In support of the rejections of claims 28 and 40 under 35 USC 103(a) based upon Perkowski, the examiner stated that:

As per claim 28, 40, Perkowski discloses:

transmitting from a consumer computer over the internet to a . . . retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer/means for transmitting from a consumer computer over the internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacture/transmission

from the a consumer to a retailer website, (Abstract, lines 11-15, client subsystem transmits a request for manufacturer products, w/ col. 10, lines 14-19, shows client system is maintained by consumers at retail outlets, in this case the consumer computer is represented by a kiosk, and the consumer makes a request over the Internet [col. 9, lines 60-63] at the retail location); [Office action mailed July 26, 2005 page 9 lines 9-18.]

The examiner's assertion that Perkowski abstract lines 11-15, column 10 lines 14-19, and column 9 lines 60-63 disclose "transmitting from a consumer computer over the Internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer" is incorrect. Instead, the examiner corresponds Perkowski's data server system to the claimed "Web site of a retailer." Specifically, in the office action mailed July 26, 2005, the examiner relied upon:

During operation, a client subsystem transmits to the database serving subsystem, a request for information which includes the UPN assigned to the consumer product on which product-related information is being sought.  
[Abstract lines 11-15.]

\* \* \*

. . . client subsystems are automatically provided with the home-page of the manufacturer's World Wide Web (WWW) site in . . . [Abstract lines 26-27.]

\* \* \*

Typically, each Client System 5 will be maintained by consumers (and/or) potential consumers of products and/or services, about which information can be found on the Internet. It is understood, however, that a Client System can be realized in the form of computer-based kiosks located in supermarkets, department stores, retail outlets, or other . . . [Column 10 lines 14-19.]

\* \* \*

. . . an Internet browser program (e.g. Netscape, Internet Explorer, Mosaic,

etc.) which includes Internet networking software that supports the TCP/IP networking protocol, and provides a GUI-based Web browser interface. [Column 9 lines 60-63.]

Perkowski's client subsystem corresponds to a consumer computer. Thus, Perkowski discloses only transmissions between the client computer and Perkowski's database server of address data. The examiner's implied assertion that Perkowski's IPSP server is a Web server of a retailer is incorrect. Perkowski column 8 lines 45-60 states that:

As shown, the on-screen IPSI Web-site Finder icon functions as an "IPSI Web-site Finder" Button 11 for instantly connecting the Client System to the IPSI Web-site (i.e., on each IPSP Server) and carrying out the Internet Product and Service Information (IPSI) finding method of the present invention. Upon selecting this button (e.g. by a clicking of the mouse), the user is automatically connected to the IPSI Web-site (supported on each IPSP Server), at whose "home page" appears the IPSI Finder and UPSN Search buttons described above appear and functionalities represented thereby. The URL for the home page of the IPSI Web-site should be selected with marketing considerations in mind, for example, "http://www.ipf.com" or "http://www.ipsi.com" similar in form with the URLs of other information search-engines and directories currently available on the Internet.

Perkowski discloses an IPSP server supporting an "IPSI Web-site Finder" button 11. Perkowski discloses that "the user selects the 'UPSN Search' button on the GUI-based browser display screen." Once this button is clicked by a mouse, the user is connected to the IPSI Web site. In response to a trademark, servicemark, and/or company name, the "Client System requests the IPSP Server S(b) to provide each registered UPSN(i) stored in the IPSI Registrant Database, and if so, then also its URL, to the Client System." Perkowski column 15 lines 11-18.

In response to the consumer's query, the Web pages that are served from the IPSP server

and the IPSI servers are associated with products registered with the IPSI registrant database. The client computer then requests the IPSI server, identified by the user-selected URL, to provide the product or service information. Perkowski column lines 19-36. However, the Web pages that are served from the IPSP server and the IPSI servers are not served from a retailer Web site.

Moreover, as stated above, Perkowski does not disclose a transmission involving a retailer web site.

Thus, Perkowski does not disclose “transmitting from a consumer computer over the Internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer,” as recited by claim 28 and defined by claim 40.

- o. Contrary to the Examiner’s Assertion, Perkowski does not Disclose “in response to receipt of said request at said Web site of said retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site”**

In support of the rejections of claims 28 and 40 under 35 USC 103(a) based upon Perkowski, the examiner stated that:

in response to receipt of said request at . . . said retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site/means for transmitting said request from said Web site of said retailer over the Internet to a remote Web site, (Col. 4, lines 63-col. 5, line 3, shows request going to IPSP server, w/ col. 6, lines 18-24, shows Internet product and service information is carried out by the IPSP Web-site); [Office action mailed July 26, 2005 page 9 lines 19-24.]

The examiner’s assertion that Perkowski column 4 line 63 through column 5 line 3 and column 6 lines 18-24 disclose “in response to receipt of said request at said Web site of said retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site” is incorrect. because Perkowski does not disclose transmitting a request from the Web



site of a retailer to a remote Web site.

Specifically, in the office action mailed July 26, 2005, the examiner relied upon:

... respectively, by simply selecting a GUI button on the Internet browser display screen in order to enter a "UPSN Search Mode", whereby (i) a dialogue box is displayed on the display screen requesting any known trademarks associated with the product, and/or the name of the company that makes, sells or distributes the particular product, and (ii) the corresponding UPN (i.e., UPC number or EPC number) registered with the IPSD Servers is displayed to the user for . . . [Perkowski column 4 line 63 through column 5 line 3.]

\* \* \*

FIG. 1B is a schematic representation of an exemplary display screen produced by a GUI-based web browser program running on a Client System and providing an on-screen IPSD Web-site Finder button for instantly connecting to the IPSD Web-site and carrying out the Internet Product and Service Information finding method of the present invention; [Perkowski column 6 lines 18-24.]

In reply, the applicant submits that the two passages above in Perkowski and Perkowski Figure 1B disclose a button that would allow the user to access the IPSI Web site in order to view, edit, or delete information pertaining to a given manufacturer's retail or wholesale operations. However, this button does not disclose transmitting said request from said Web site of said retailer over the Internet to a remote Web site.

Moreover, as stated above, nothing in Perkowski, discloses that a client subsystem transmits a request to a Web site of a retailer; and the examiner's assertion that it was obvious that Perkowski discloses that a request goes to the Web site of a retailer is incorrect. Therefore, Perkowski could not disclose acting in response to receipt of a request at a retailer Web site.

Thus, Perkowski does not disclose "in response to receipt of said request at said Web site of said retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site," as recited by claim 28 and defined by claim 40.

- p. **Contrary to the Examiner's Assertion, Perkowski does not Disclose "in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives"**

In support of the rejections of claims 28 and 40 under 35 USC 103(a) based upon Perkowski, the examiner stated that:

in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said . . . retailer a list of manufacturer incentives/means for transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives; (Col. 5, lines 1-8, shows URLs accessed from the IPSD server and displayed on the display screen of the internet browser, w/ col. 4 lines 44-51, shows that URL categories include Product Incentives). [Office action mailed July 26, 2005 page 10 lines 3-9.]

The examiner's assertion that Perkowski column 5 lines 1-8 and column 4 lines 44-51 disclose "in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives" is incorrect. Instead, the passages in Perkowski disclose (1) a client querying the IPSD servers to locate a URL of a desired product and (2) database information fields which contain information regarding manufacturers and service providers. Specifically, in the office action mailed July 26, 2005, the examiner relied upon:

. . . makes, sells or distributes the particular product, and (ii) the corresponding UPN (i.e., UPC number or EPC number) registered with the IPSD Servers is displayed to the user for acceptance, whereupon the Internet information resource locators (URLs) are automatically accessed from the IPSD Servers and displayed on the display screen of the Internet browser for subsequent URL selection and Web-site connection. [Column 5 lines 1-8.]

\* \* \*

Another object of the present invention is to provide such a product information finding system, wherein the URLs symbolically linked to each registered product in the IPSD Servers thereof are categorized as primarily relating to Product Advertisements, Product Specifications, Product Updates, Product Distributors, Product Warranty/Service, and/or Product Incentives (e.g. rebates, discounts and/or coupons), and that such URL categories are graphically displayed to the requester by way of easy-to-read display screens during URL selection and Web-site connection . . . [Column 4 lines 44-53.]

In reply, the applicant submits that Perkowski does not disclose transmitting from a remote Web site to the Web site of a manufacturer. The examiner's implied assertion in the office action mailed July 26, 2005 at page 10 lines 6-8 that the display screen of the Internet browser server is a retailer Web site is clearly incorrect. Perkowski discloses a system in which the consumer transmits a request to the database serving subsystem (either the IPSD or IPSI), and the database serving system looks up information in its local database and returns the URL of a desired product to the client computer. That is a 2-computer process involving only transmission between a consumer computer and a server.

Perkowski column 5 lines 1-8 discloses that the consumer accesses Perkowski's IPSD server, which displays the UPN for acceptance by the consumer. The consumer may subsequently select the desired URLs and connect to the desired manufacturer Web sites. This passage indicates that Perkowski does not transmit data from a remote site to the Web site of a manufacturer. As stated above, Perkowski does not disclose accessing a retailer Web site. Instead, Perkowski discloses the display of the URL of a manufacturer Web site in the browser of the client system.

Perkowski column 4 lines 44-53 discloses that Perkowski's IPSD server categorizes URLs and that one of those categories is an association with product incentives. However, Perkowski's disclosure of the browser of a client system containing a listing of URLs categorized because of an association with product incentives, is not patentably equivalent to the disclosure

of the transmission of a list of manufacturer incentives, as disclosed in claim 28 and recited in claim 40. Therefore, Perkowski does not disclose a transmission from a remote Web site to the Web site of a retailer containing a list of manufacturer incentives.

Thus, Perkowski does not disclose “in response to receipt of region data at said manufacturer’s Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer,” as recited by claim 28 and defined by claim 40.

- q. **Contrary to the Examiner’s Assertion, Perkowski does not Disclose “in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives”**

In support of the rejections of claims 28 and 40 under 35 USC 103(a) based upon Perkowski, the examiner stated that:

In response to receipt of said manufacturers incentives at said . . . retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives/means for transmitting over the Internet to. said consumer computer said list of manufacturers incentives, (Col. 5, lines 6-8, shows subsequent URL selection [done by consumer]). [Office action mailed July 26, 2005 page 10 lines 10-14.]

The examiner’s assertion that Perkowski column 5 lines 6-8 discloses “in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives,” as recited by claim 28 and defined by claim 40, is incorrect. Instead, the passage in Perkowski discloses displaying the URLs of manufacturers that correspond to the consumers’ requests for product information. Specifically, in the office action mailed July 26, 2005, the examiner relied upon:

... Servers and displayed on the display screen of the Internet browser for subsequent URL selection and Web-site connection. [Perkowski column 5 lines 6-8.]

In reply, the applicant submits that Perkowski does not disclose a list of manufacturer's incentives to either (1) the Web site of a retailer or (2) the consumer computer. The examiner's implied assertion in the office action mailed July 26, 2005 at page 10 lines 13-14 that the displaying of URLs to the client consists of manufacturer's incentives is clearly incorrect. As stated above, Perkowski's disclosure of the browser of a client system containing a listing of URLs categorized because of an association with product incentives, is not patentably equivalent to the disclosure of the transmission of a list of manufacturer incentives. Moreover, as stated above, Perkowski does not disclose a request going to the Web site of a retailer.

Thus, Perkowski does not disclose "in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives," as recited by claim 28 and defined by claim 40.

For all of the reasons presented above, the rejections of claims 28 and 40 are improper and should be reversed.

**r. Contrary to the Examiner's Assertion, Perkowski Does not Disclose "transmission from a consumer to a retailer website"**

In support of the rejections of claims 50 and 51 under 35 USC 103(a) based upon Perkowski, the examiner stated that:

As per claims 50, 51 Perkowski discloses:

Transmission/Mean for transmitting from a consumer to a retailer website, (Abstract, lines 11-15, client subsystem transmits a request for manufacturer products, and the client subsystem is provided with the homepage of the manufacturer's World Wide Web site as shown in the abstract, lines 26-27, w/ .col. 10, lines 14-19, shows client system is maintained by consumers at retail

outlets, in this case the consumer computer is represented by a kiosk, and the consumer makes a request over the Internet [col. 9, lines 60-63] at the retail location); [Office action mailed July 26, 2005 page 11 lines 3-10.]

The examiner's assertion that Perkowski Abstract lines 11-15 and lines 26-27, column 10 lines 14-19 and column 9 lines 60-63 discloses transmission from a consumer to a retailer website, is incorrect. The passages in Perkowski relied upon by the examiner are copied *supra*.

In reply, the applicant submits that these passages disclose that a client system can be located in a retail outlet. Neither this passage, nor any part of Perkowski, discloses a transmission involving the Web site of a retailer. Moreover, the examiner's possibly assumed conclusion that Perkowski's web site is a retailer web site because it may be hosted by a retailer's computer is incorrect, because Perkowski web site provides links to other (and clearly competing) retailer web sites and that functionality is inconsistent.

Thus, Perkowski does not disclose "transmission from a consumer to a retailer website," as recited by claim 50 and defined by claim 51.

s.        **Contrary to the Examiner's Assertion, Perkowski Does not Disclose "transmission from the retailer website to a remote website"**

In support of the rejections of claims 50 and 51 under 35 USC 103(a) based upon Perkowski, the examiner stated that:

Transmission/Mean for transmitting from the retailer website to a remote website, (Col. 4, lines 63-col. 5, line 3, shows request going to IPSD server, where region data such as Web site addresses for the manufacturer is shown to be transmitted to the IPSD server by way of registration as shown in col. 5, lines 52-59, w/ col. 6, lines 18-24, shows Internet product and service information is carried out by the IPSD Web-site); and [Office action mailed July 26, 2005 page 11 lines 11-16.]

The examiner's assertion that Perkowski column 4 lines 63 through column 5 lines 3, column 5 lines 52-59, and column 6 lines 18-24 discloses transmission from the retailer website to a remote website, is incorrect. The passages in Perkowski relied upon by the examiner are copied *supra*.

In reply, the applicant submits that no part of Perkowski discloses a transmission involving the Web site of a retailer. Perkowski column 5 lines 52-59 discloses the solicitation of registration of manufacturers within the databases of IPSD servers. Perkowski column 4 lines 63 through column 5 lines 3 and column 6 lines 18-24 discloses a button that would allow the user to access the IPSI Web site in order to view, edit, or delete information pertaining to a given manufacturer's retail or wholesale operations. However, neither the solicitation of the manufacturers nor the IPSI access button disclose transmitting a request from a retailer Web site to a remote Web site.

Thus, Perkowski does not disclose "transmission from the retailer website to a remote website," as recited by claim 50 and defined by claim 51.

**t. Contrary to the Examiner's Assertion, Perkowski Does not Disclose "transmission from the remote website to the retailer website, of a list of manufacturer incentives"**

In support of the rejections of claims 50 and 51 under 35 USC 103(a) based upon Perkowski, the examiner stated that:

Transmission/Mean for transmitting from the remote website to the to the retailer website, of a list of manufacturer incentives, (Col. 5, lines 1-8, shows URLs accessed from the IPSD server and displayed on the display screen of the internet browser, w/ col. 4 lines 44-51, shows that URL categories include Product Incentives). [Office action mailed July 26, 2005 page 11 lines 17-20.]

The examiner's assertion that Perkowski column 5 lines 1-8 and column 4 lines 44-51 discloses transmission from the remote website to the retailer website, of a list of manufacturer

incentives, is incorrect. The passages in Perkowski relied upon by the examiner are copied *supra*.

In reply, the applicant submits that no part of Perkowski discloses a transmission involving the Web site of a retailer, so Perkowski does not disclose transmitting from a remote Web site to the Web site of a retailer.

Perkowski column 5 lines 1-8 discloses that the consumer accesses Perkowski's IPSD server, which displays the UPN for acceptance by the consumer. The consumer may subsequently select the desired URLs and connect to the desired manufacturer Web sites. This passage indicates that Perkowski does not transmit data from a remote site to the Web site of a manufacturer. As stated above, Perkowski does not disclose accessing a retailer Web site. Instead, Perkowski discloses the display of the URL of a manufacturer Web site in the browser of the client system.

Perkowski column 4 lines 44-53 discloses that Perkowski's IPSD server categorizes URLs and that one of those categories is an association with product incentives. However, Perkowski's disclosure of the browser of a client system containing a listing of URLs categorized because of an association with product incentives, is not patentably equivalent to the disclosure of the transmission of a list of manufacturer incentives, as disclosed in claim 50 and recited in claim 51.

Thus, Perkowski does not disclose "transmission from the remote website to the retailer website, of a list of manufacturer incentives," as recited by claim 50 and defined by claim 51.

For all of the reasons presented above, the rejections of claims 50 and 51 are improper and should be reversed.



- u. **Contrary to the Examiner's Assertion, Perkowski in View of Sloane does not Disclose the "transmitting a user identification from said Web site of said retailer over the Internet to said remote Web site in association with said request; and determining manufacturer's incentives to transmit from said remote Web site to said Web site of said retailer based upon said user identification" Limitation Defined by Claims 29 and 41**

In support of the rejections of claims 29 and 41 under 35 USC 103(a) based upon Perkowski in view of Sloane, the examiner stated that:

As per claims 29, 41, Perkowski fails to disclose transmitting a user identification from said Web site of said retailer over the Internet to said remote Web site in association with said request and determining manufacturer's incentives to transmit from said remote Website to said Web site of said retailer based upon said user identification, but does disclose the transmission of manufacturer's incentives to consumers in Col. 12, lines 16-20.

However, Sloane discloses:

transmitting a user identification from said Web site of said retailer over the Internet to said remote Web site in association with said request/means for transmitting a user identification ...determining manufacturer's incentives to transmit from said remote Website to said Web site of said retailer based upon said user identification/means for determining manufacturer's incentives, (Col. 9, lines 52-58, Claim 12, Claim 15, shows usage of consumer identification in conjunction with transmitting consumer product information). Sloane discloses this limitation in an analogous art for the purpose of showing that a consumer identification can affect the transmittal of consumer product information.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to transmit a user identification from said Web site of

said retailer over the Internet to said remote Web site in association with said request and determining manufacturer's incentives to transmit from said remote Web site to said Web site of said retailer based upon said user identification with the motivation of sending the consumer an incentive which is identified by consumer id. [Office action mailed July 26, 2005 page 11 line 23 through page 12 line 23.]

The examiner's assertions that Perkowski discloses the transmission of manufacturer's incentives to consumers, that there is a motivation to combine Perkowski and Sloane, or that Perkowski in view of Sloane discloses "transmitting a user identification from said Web site of said retailer over the Internet to said remote Web site in association with said request"; or "determining manufacturer's incentives to transmit from said remote Web site to said Web site of said retailer based upon said user identification" are all incorrect, for the reasons previously stated.

Furthermore, the examiner's assertion at page 12 lines 6-7 of the office action mailed July 26, 2005 that Perkowski discloses "the transmission of manufacturer's incentives to consumers in Col. 12, lines 16-20" is incorrect. Perkowski column 12 lines 16-20 states that:

... (ii) a five digit product number assigned to the product by the manufacturer; and (iii) a one digit modulo check digit (mathematically calculated) and added to each UPC number to ensure that the code has been read correctly by the bar code reader.

This passage discloses adding a check digit to a manufacturer's product number to ensure an accurate reading of a bar code. This passage does not disclose the transmission of manufacturer's incentives to consumers.

Since Sloane does not overcome Perkowski's deficiencies noted above, the rejections of claims 29 and 41 based upon Perkowski and Sloane are improper and should be reversed.

Moreover, Sloane fails to disclose what the examiner alleged.

In fact, Sloane teaches a consumer using a portable UPC bar code scanner at a retail store to scan products that the consumer is interested in purchasing. The scanner notifies the consumer of any promotion associated with the scanned product. The promotion can be sent wirelessly directly to the scanner from the computer of either the retailer product manufacturer. Sloane teaches that this wireless transmission contains user identification.

Sloane does not teach either (1) "transmitting a user identification from said Web site of said retailer over the Internet to said remote site in association with said request," as recited in claim 29 or (2) "determining manufacturer's incentives to transmit from said remote Web site to said Web site of said retailer based upon said user identification," as recited in claim 29.

The examiner relied on the following passages from Sloane:

... processing means including data receiving means for receiving consumer product and promotional information, data storage means for storing the received consumer, product and promotional information, and data transmission means for transmitting the stored consumer product and promotional information within the retail establishment; [Column 9 lines 52-58.]

12. The apparatus according to claim 11, wherein said consumer identification information consists of the consumer's identity, and the purchasing history of the identified consumer. [Claim 12.]

15. The apparatus according to claim 14, wherein said identification receiving means comprises an opening in said portable bar code scanner center for receiving the consumer's identification information. [Claim 15.]

Sloane is directed to:

A system and method for influencing and potentially altering a consumer's purchase decisions at the point-of-purchase in a retail store using a portable bar

code scanner that is in constant wireless communication with the store and a retailer/manufacturer's computer/controller. [Abstract, first sentence.]

\* \* \*

More particularly, it relates to a method and apparatus for alerting consumers of sales, or other product promotions, to motivate or alter their purchasing decisions at the point-of-purchase, and further, a security system for the apparatus. [Sloane column 1 lines 11-15.]

In the office action mailed July 26, 2005 at page 12 lines 13-17, the examiner stated that:

(Col. 9, lines 52-58, Claim 12, Claim 15, [of Sloane] shows usage of consumer identification in conjunction with transmitting consumer product information). Sloane discloses this limitation in an analogous art for the purpose of showing that a consumer identification can affect the transmittal of consumer product information. [Interpolation supplied.]

The examiner did not cite to Sloane for the disclosure of the limitation "transmitting a user identification from said Web site of said retailer over the Internet to said remote Web site in association with said request; and determining manufacturer's incentives to transmit from said remote Web site to said Web site of said retailer based upon said user identification" in an analogous art. The applicant believes the examiner is referring to Sloane column 2 lines 17-21, which states that:

Other methods of issuing electronic coupons or promotions to the consumer's frequent shopper electronic account includes consumer requested promotion/coupons through the use of their home computer and an online computer network, such as, for example, the internet.

The applicant submits that Sloane's disclosure of an analogous art is for the purpose of

disclosing that Sloane teaches away from that prior art. This is evidenced by the paragraph in Sloane that immediately follows the examiner's cite. Sloane column 2 lines 22-29 states that:

The primary drawback with the frequent shopper card systems is that the identity of the consumer is not determined until after the purchase selections have been made. Thus, no information concerning the purchases made on previous shopping trips can be used as a basis for offering the consumer promotional product information during the time these consumers/frequent shopper club members, are making their current purchase selections.

For all of the reasons presented above, neither Perkowski, nor Sloane disclose "transmitting a user identification from said Web site of said retailer over the Internet to said remote Web site in association with said request;" and "determining manufacturer's incentives to transmit from said remote Web site to said Web site of said retailer based upon said user identification," as recited by claim 29 and defined by claim 41.

Moreover, the examiner has not provided proper reasoning explaining why one of ordinary skill in the art at the time of the invention would have found a motivation or suggestion to combine the teachings of Sloane with the teachings of Perkowski to obtain the subject matter of claims 29 and 41, absent impermissible hindsight.

The examiner's stated motivation for combining Sloane with Perkowski is "sending the consumer an incentive which is identified by customer id." Office action mailed July 26, 2005 page 12 lines 22-23. The examiner improperly uses circular logic because the examiner's stated motivation is the same as the limitation recited in claim 29 and defined by claim 41 that the examiner argued is obvious based upon Perkowski in view of Sloane: "transmitting a user identification from said Web site of said retailer over the Internet to said remote Web site in association with said request [for manufacturer incentives]."

Thus, Perkowski based upon Sloane does not disclose "transmitting a user identification from said Web site of said retailer over the Internet to said remote Web site in association with said request" or "determining manufacturer's incentives to transmit from said remote Web site to

said Web site of said retailer based upon said user identification,” as recited by claim 29 and defined by claim 41. Therefore, applicants respectfully submit that the rejections of claims 29 and 41 under 35 USC 103(a) as being obvious based upon Perkowski in view of Sloane are improper and should be reversed.

Claims 29 and 41 depend from claims 28 and 40, respectively. Therefore, the rejections of claims 29 and 41 are improper and should be reversed for the same reasons as for claims 28 and 40.

**v. Contrary to the Examiner’s Assertion, Perkowski in View of  
Smolen does not Disclose the “region data is postal code data”  
Limitation of Claims 31 and 43**

In support of the rejections of claims 31 and 43 under 35 USC 103(a), the examiner stated that:

As per claims 31, 43, Perkowski fails to teach wherein said region data is postal code data, but does disclose region data through URLs in col.11, lines 42-43.

However Smolen discloses:

wherein said region data is postal code data, (Col. 4, lines 64-67, represented by postal code). Smolen discloses this limitation in an analogous art for the purpose of showing that postal code data can be incorporated into a system for transmitting incentives.

It would have been obvious to one of ordinary skill in the art for the region data to be postal code data in order to determine the location of the retailer versus the location of the user for incentive transmittal purposes. [Office action mailed July 26, 2005 page 13 lines 6-15.]

The examiner’s assertion that Perkowski in view of Smolen discloses that region data is postal code data is incorrect.

Perkowski fails to disclose the limitations of the independent claims, and Smolen does not overcome that deficiency. Therefore, the rejections of claims 31 and 43 based upon Perkowski and Smolen are improper and should be reversed.

Smolen is directed to:

A method and apparatus for offering promotions to a consumer on the basis of a dynamic information profile for that consumer. [Abstract, first sentence.]

\* \* \*

The invention relates to a method and apparatus for delivering promotions to a person, household or business on the basis of a dynamic information profile for that person, household or business, the dynamic information profile being formed by creating an initial information profile for the person or household, selecting one or more questions based on the information profile, presenting the one or more questions to a person in the household, collecting the responses to the one or more questions, and updating the information profile using the responses to the questions. Promotions can be offered to a person or household based upon the state of the entire information profile or a portion of the information profile. [Smolen column 1 lines 4-16.]

Smolen teaches surveying a consumer at a remote location and providing promotions to the consumer based upon the consumer's information profile. Smolen teaches storing telephone numbers provided consumers, at column 4 lines 64-67, stating that:

If the telephone number is used as the code, it is preferably considered part of the information profile because the area-code and exchange make valuable demographic additions to the profile.

In reply, the applicants submit that Smolen does not teach surveying a consumer "wherein

said region data is postal code data,” as recited in claim 31.

Smolen does not disclose postal code data. Moreover, a telephone number is not a postal code or geographic indicator.

In the office action mailed July 26, 2005 at page 13 lines 10-12, the examiner relied upon Smolen’s telephone number disclosure at Smolen column 4 lines 64-67 for the assertion that:

Smolen discloses this limitation [transmitting postal code data from the consumer to the retailer] in an analogous art for the purpose of showing that postal code data can be incorporated into a system for transmitting incentives.

[Interpolation supplied.]

However, storing a telephone number does not suggest a consumer transmitting to a retailer a Web site postal code. Therefore, Smolen does not suggest the limitation defined by claims 31 and 43.

For all of the reasons presented above, neither Perkowski, nor Smolen disclose “wherein said region data [from the consumer to the retailer] is postal code data,” as recited by claim 31 and defined by claim 43.

Therefore, the applicant respectfully submits that the rejections of claims 31 and 43 under 35 USC 103(a) as being obvious based upon Perkowski and Smolen are improper and should be reversed.

Claims 31 and 43 depend from claims 30 and 42, respectively. Therefore, the rejections of claims 31 and 43 are improper and should be reversed for the same reasons as for claims 30 and 42.

#### **H. 37 CFR 41.37 (c)(1)(viii) Claims Appendix**

Appendix I is attached which contains a copy of the claims involved in the appeal.



**I. 37 CFR 41.37 (c)(1)(ix) Evidence Appendix**

A copy of the BPAI decision in this sister case, the 3 prior decision in the related case, and the order from the CAFC remanding the related case to the USPTO are attached as appendices.

**J. 37 CFR 41.37 (c)(1)(x) Related Proceedings Appendix**

A copy of the four decisions rendered in this or related proceedings are attached.

**IV. 37 CFR 41.37 (c)(2)**

The applicant submitted a 37 CFR 1.116(a)(2) amendment, as noted herein. Presumably, that amendment will have been entered when you decide this appeal.

**V. 37 CFR 41.37 (d)**

This brief is in compliance with the requirements of paragraph (c) of this section. Accordingly, this section is inapplicable.

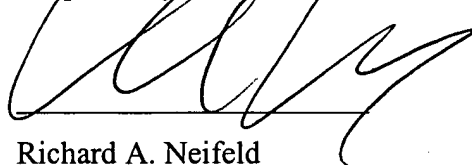
**VI. 37 CFR 41.37 (e)**

The applicant herewith timely files the appeal brief.

12/22/05

DATE

Respectfully Submitted,



Richard A. Neifeld

Attorney of Record

Registration No. 35,299

RLB/BTM

Printed: December 22, 2005 (1:10pm)

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## Appendix I

24. A computer network implemented method, comprising the steps of:
- transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer;
  - in response to said request for manufacturer incentives, transmitting region data from said Web site of said manufacturer over the Internet to a remote Web site;
  - in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and
  - transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address.
25. The method according to claim 24, wherein said step of transmitting from said remote site further comprises transmitting a link to a Web site of said retailer.
26. The method according to claim 24, further comprising the step of determining said at least one manufacturer's incentive and said at least one name and address of a retailer by querying, using said region data, a database from a server of said remote Web site.
27. The method according to claim 24, further comprising the steps of:
- transmitting from said consumer computer to said Web site of said manufacturer selection data indicating selection of said at least one manufacturer incentive;
  - transmitting from said Web site of said manufacturer to said remote site said selection data;
  - transmitting from said remote site to said Web site of said manufacturer details of the selected at least one manufacturer incentive; and
  - transmitting from said Web site of said manufacturer to said consumer computer said details.
28. A computer network implemented method, comprising the steps of:
- transmitting from a consumer computer over the Internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a

manufacturer;

in response to receipt of said request at said Web site of said retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site;

in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives; and

in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives.

29. The method according to claim 28, further comprising the steps of:

transmitting a user identification from said Web site of said retailer over the Internet to said-remote Web site in association with said request; and

determining manufacturer's incentives to transmit from said remote Web site to said Web site of said retailer based upon said user identification.

30. The method according to claim 28, further comprising the step of transmitting from the consumer computer over the Internet to the Web site of the retailer region data.

31. The method according to claim 30, wherein said region data is postal code data.

32-35. (Canceled)

36. A computer network implemented system, comprising:

means for transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer;

means for, in response to said request for manufacturer incentives, transmitting region data from said Web site of said manufacturer over the Internet to a remote Web site;

means for, in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and

means for transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address.

37. The system according to claim 36, wherein said means for transmitting from said

remote site said list further comprises means for transmitting a link to a Web site of said retailer.

38. The system according to claim 36, further comprising means for determining said at least one manufacturer's incentive and said at least one name and address of a retailer by querying, using said region data, a database from a server of said remote Web site.

39. The system according to claim 36, further comprising:

means for transmitting from said consumer computer to said Web site of said manufacturer selection data indicating selection of said at least one manufacturer incentive;

means for transmitting from said Web site of said manufacturer to said remote site said selection data;

means for transmitting from said remote site to said Web site of said manufacturer details of the selected at least one manufacturer incentive; and

means for transmitting from said Web site of said manufacturer to said consumer computer said details.

40. A computer network implemented system, comprising:

means for transmitting from a consumer computer over the Internet to a Web site of a retailer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer;

means for, in response to receipt of said request at said Web site of said retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site;

means for, in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives; and

means for, in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives.

41. The system according to claim 40, further comprising:

means for transmitting a user identification from said Web site of said retailer over the Internet to said remote Web site in association with said request; and

means for determining manufacturer's incentives to transmit from said remote Web site to

said Web site of said retailer based upon said user identification.

42. The system according to claim 40, further comprising means for transmitting from the consumer computer over the Internet to the Web site of the retailer region data.

43. The system according to claim 42, wherein said region data is postal code data.

44-47. (Canceled)

48. A computer program product for implementing on a network a method, comprising the steps of:

in response to receiving at a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer transmitted from a consumer computer over the Internet, transmitting region data from a Web site of said manufacturer over the Internet to a remote Web site;

in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and

transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address.

49. A computer program product for performing a computer network implemented method, comprising the steps of:

in response to receipt of a request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer transmitted from a consumer computer over the Internet to a Web site of a retailer, transmitting said request from said Web site of said retailer over the Internet to a remote Web site;

in response to receipt of said request at said remote site, transmitting from said remote site over the Internet to said Web site of said retailer a list of manufacturer incentives; and

in response to receipt of said manufacturers incentives at said Web site of said retailer, transmitting over the Internet to said consumer computer said list of manufacturers incentives.

50. A computer implemented method comprising performing transactions involving multiple separate entities, including

transmission from a consumer to a retailer website,

transmission from the retailer website to a remote website, and  
transmission from the remote website to the retailer website, of a list of manufacturer  
incentives.

51. A system comprising structure for performing transactions involving multiple  
separate entities, including:

means for transmitting from a consumer to a retailer website,

means for transmitting from the retailer website to a remote website, and

means for transmitting from the remote website to the retailer website, of a list of  
manufacturer incentives.

### **37 CFR 41.37(c)(1)(x) - Related Proceedings Appendix**

Copy of BPAI decision on appeal in 09/505,632; BPAI appeal no: 2002-0329 (bates stamped pages 000503 to 000513 is Attachment 1.

Copy of BPAI decision on appeal in 08/873,974; BPAI appeal no: 2004-1267 (bates stamped pages 000483 to 000494 is Attachment 2.

Copy of BPAI decision on rehearing in 08/873,974; BPAI appeal no: 2004-1267 (bates stamped pages 000519 to 000525 is Attachment 3.

Copy of CAFC order dated March 9, 2005 remanding 05-1164 to the USPTO is Attachment 4.

RLB/BTM

Printed: December 22, 2005 (1:10pm)

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Attachment 1



11/3/03  
CS [JointAppendix.pdf]esStamped\_CAT-34-SCRO-US\_050205.pdf]

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

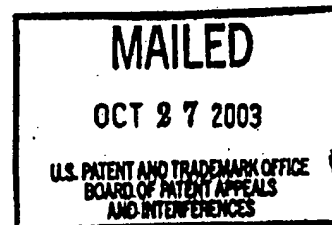
Review Date: 11/27/03

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte MICHAEL C. SCROGGIE, DAVID A. ROCHON,  
DAVID W. BANKER and WILL GARDENSWARTZ

Appeal No. 2002-0329  
Application No. 09/505,632

ON BRIEF



Before KRASS, JERRY SMITH and RUGGIERO, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 24-31, 34, 36-43, 46, 48 and 49.

The invention maintains a database of manufacturer offers and retailer special deals at a cooperative network site where consumers can access at least a subset of the data in the database from any manufacturer or retailer network site.

-1-

Attachment 1

APDEC-CAT34SCROCCP-031103 CS

In re SCROGGIE  
Appeal No. 05-1164  
000503



Appeal No. 2002-0329  
Application No. 09/505,632

Accordingly, it makes little difference which site, whether manufacturer or retailer, that the consumer is logged in to when initiating the request since the data is received directly from the cooperative site. The result is that manufacturer offers and retailer special deals are exposed to many more consumers.

Representative independent claim 24 is reproduced as follows:

24. A computer network implemented method, comprising the steps of:

transmitting from a consumer computer over the Internet to a Web site of a manufacturer a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer;

in response to said request for manufacturer incentives, transmitting region data from said Web site of said manufacturer over the Internet to a remote Web site;

in response to receipt of region data at said manufacturer's Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer; and

transmitting from said Web site of said manufacturer over the Internet to said consumer computer said at least one manufacturer incentive and said at least one name and address.

The examiner relies on the following references:

Smolen	5,915,243	Jun. 22, 1999 (filed Aug. 29, 1996)
Sloane	5,918,211	Jun. 29, 1999 (filed May 30, 1996)

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Application No. 09/505,632

Hoffman et al. (Hoffman) 6,012,039 Jan. 4, 2000  
(effectively filed Aug. 29, 1996)

Claims 28, 34, 40 and 46 stand rejected under 35 U.S.C.  
§ 102(e) as anticipated by Sloane.

Claims 24-27, 29-31, 36-39, 41-43, 48 and 49 stand rejected  
under 35 U.S.C. § 103. As evidence of obviousness, the examiner  
cites Sloane and Hoffman with regard to claims 24, 25, 27, 29,  
36, 37, 39, 41, 48 and 49, adding Smolen to this combination with  
regard to claims 26, 30, 31, 38, 42 and 43.

Reference is made to the briefs and answer for the  
respective positions of appellants and the examiner.

#### OPINION

Turning, initially, to the rejection under 35 U.S.C.  
§ 102(e), an anticipatory reference is one which describes all of  
the elements of the claimed invention so as to have placed a  
person of ordinary skill in the art in possession thereof. In re  
Spada, 911 F.2d 205, 15 USPQ2d 1655 (Fed. Cir. 1990).

It is the examiner's position that Sloane discloses, at  
column 7, lines 5-10, the transmission from a consumer computer  
of a request for manufacturer incentives; at column 7, lines 13-

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Application No. 09/505,632

22, the transmission of region data from the website of a manufacturer in response to the request for manufacturer incentives; at column 7, lines 22-26, transmission from a remote website to the manufacturer website at least one manufacturer incentive and at least one name and address of a retailer in response to receipt of region data at the manufacturer's website; and, at column 7, lines 36-40, updating a manufacturer's incentive database.

The examiner also cites column 8, lines 3-7, of Sloane as part of the rationale for the rejection.

The examiner contends that it is inherent to include graphical image data corresponding to manufacturer incentives because Sloane does disclose that his communication line can be an online computer network or the Internet (column 7, lines 18-22) -See answer-page 4.

It is appellants' view that although Sloane does disclose processing incentives between a retailer, or product manufacturer, and a retailer computer/controller 12 over a communication network 200, Sloane does not disclose or suggest distributing product incentives to consumers over the internet (principal brief-page 7). Furthermore, argue appellants, "the communication sequence defined by the present invention is

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Application No. 09/505,632

clearly a request-response transaction involving three distinct entities, namely, a consumer computer, a manufacturer website, and a remote website, using a request-response communication protocol" (reply brief-page 2).

We agree with appellants that the subject matter of independent claims 28 and 40 is not anticipated by Sloane. These claims clearly call for a transaction involving multiple separate entities, i.e., transmission from a consumer to a retailer website, transmission from the retailer website to a remote website, and transmission from the remote website to the retailer website, of a list of manufacturer incentives. Finally, the retailer website transmits to the consumer a list of these incentives.

In Sloane, there is no middle-man communication. Incentives are communicated to the consumer by either the retailer or another sender of information, e.g., the manufacturer. There is no transmission from a retailer website to a remote website in response to an inquiry from a consumer to the retailer website. The examiner identifies Figure 3b of Sloane, indicating that the sender of promotion information, 16, is indicative of a "remote website."

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The sender of promotion information 16 in Sloane is, indeed, sent from a remote site, e.g., the manufacturer. However, this information is communicated as an alternative to the retailer supplying incentive information. Moreover, this remote site 16 in Sloane, does not provide information "in response to receipt of said request at said Web site of said retailer," as required by the claims.

Accordingly, we will not sustain the rejection of claims 28 and 40 under 35 U.S.C. § 102(e).

With regard to claims 34 and 46, these claims are a bit broader in scope. They do not recite the separate communications of claims 28 and 40. In fact, claims 34 and 46 merely require a transmission from a manufacturer to a remote Web site regarding manufacturer incentive data, and then updating the manufacturer's incentives database, including graphical image data corresponding to the manufacturer's incentives.

Sloane clearly teaches, in Figure 3b, communicating manufacturer incentive data from the manufacturer to a remote Web site. The sender of promotional information, 16, may be a manufacturer (column 7, lines 11-13) and the information is sent to the consumer, at the retail computer 12, the retail computer 12 being remote from the manufacturer.

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Application No. 09/505,632

Clearly, the information in Sloane is sent over the internet (column 7, line 22). When the manufacturer transmits this information to computer/controller 12, the information is clearly an "update" of the manufacturer's incentives database. The examiner calls this feature "inherent" and we would agree.

The only limitation of claims 34 and 46 not explicitly, or implicitly, disclosed by Sloane is "graphical image data corresponding to said manufacturers incentives." The examiner calls this a "traditional practice to present data using a graphical user interface which presents graphical image data" (answer-page 4), and holding such a disclosure in Sloane to be inherent.

Appellants' position is that Sloane does not disclose updating a manufacturers incentives database storing data defining manufacturers incentives including graphical image data corresponding to the manufacturers incentives with the manufacturer incentive data (principal brief-page 10). While it may be "traditional" to present data using a graphical user interface which presents graphical image data over the internet, "this in-and-of-itself does not teach nor suggest storing data defining manufacturers incentives including graphical image data

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corresponding to the manufacturers incentives, as in the claimed invention" (principal brief-page 10).

Since appellants do not deny that it is "traditional" to present data using a graphical user interface which presents graphical image data over the internet and Sloane clearly discloses storage of data defining manufacturers incentives by updating such information in a remote site via the internet, we will sustain the examiner's rejection under 35 U.S.C. § 102(e) since the consumer using the retailer computer/controller will be using a graphical user interface (GUI) to interface with the incentives information stored therein.

While we have sustained the rejection of claims 34 and 46 under 35 U.S.C. § 102(e), because appellants have not convinced us of error in the examiner's reasoning, it is our view that the rejection would have been stronger had it been made under 35 U.S.C. § 103 since, while not explicitly shown by Sloane, it would have been obvious for the consumer to interact with the retailer computer/controller via a GUI regarding the available manufacturers incentives. In any event, it would have been obvious to store the incentives "including graphical image data" since, as admitted by appellants, it is "traditional" to present data using a GUI.

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Application No. 09/505,632

With regard to the rejections under 35 U.S.C. § 103, we will not sustain these rejections because each of the independent claims 24, 36, 48 and 49 includes limitations similar to those in claims 28 and 40, i.e., transactions involving multiple separate entities, wherein there is transmission from a consumer to a retailer website, transmission from the retailer website to a remote website, and transmission from the remote website to the retailer website, of a list of manufacturer incentives. Finally, the retailer website transmits to the consumer a list of these incentives. As explained supra, Sloane is devoid of any such teaching. Moreover, neither Hoffman nor Smolen provides for this deficiency of Sloane. Accordingly, the examiner has not made out a prima facie case of obviousness with regard to the subject matter of claims 24-27, 29-31, 36-39, 41-43, 48 and 49 and we will not sustain the rejection of these claims under 35 U.S.C. § 103.

#### CONCLUSION

We have sustained the rejection of claims 34 and 46 under 35 U.S.C. § 102(e) but we have not sustained the rejection of claims 28 and 40 under 35 U.S.C. § 102(e) or the rejection of claims 24-27, 29-31, 36-39, 41-43, 48 and 49 under 35 U.S.C. § 103.

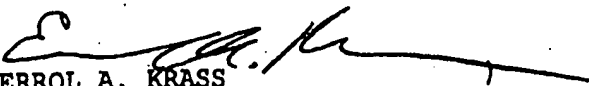


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Accordingly, the examiner's decision is affirmed-in-part.

No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136(a).

AFFIRMED-IN-PART

  
ERROL A. KRASS  
Administrative Patent Judge

  
JERRY SMITH  
Administrative Patent Judge

  
JOSEPH F. RUGGIERO  
Administrative Patent Judge

BOARD OF PATENT  
APPEALS AND  
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Appeal No. 2002-0329  
Application No. 09/505,632

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2001 JEFFERSON DAVIS HIGHWAY  
SUITE 1001  
ARLINGTON, VA 22202

7/30/04  
EB

[JointAppendix.pdf]esStamped\_CAT-34-SCRO-US\_050205.pdf]

Attachment 2



The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 51

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Action Re Dec. on App.

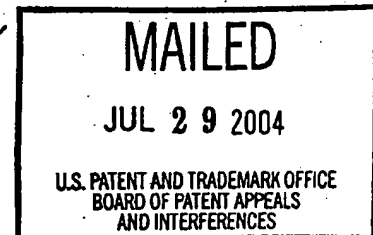
8-604

Ex parte MICHAEL C. SCROGGIE, DAVID A. ROCHON,  
DAVID W. BANKER and WILL GARDENSWARTZ

Appeal No. 2004-1267 ✓  
Application No. 08/873,974 ✓

CAT/34-SCRO-US

ON BRIEF



Before KRASS, FLEMING and DIXON, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the rejection of twice-rejected claims 50-89.

The invention is directed to a system, process and computer program product for distributing product incentives to consumers over a communication network.

Attachment 2

-1-

Dec App- CAT34SCROUS-040730 re SCROGGIE  
Appeal No. 05-1164  
000483

Appeal No. 2004-1267  
Application No. 08/873,974

Representative independent claim 50 is reproduced as follows:

50. A system for distributing product incentives to consumers over a communication network, comprising:

a cooperative network site configured to store at least one of (i) manufacturer incentives to purchase one of a product and a service offered by a manufacturer and (ii) retailer incentives to purchase one of a product and a service offered by a retailer;

at least one of a manufacturer network site and a retailer network site coupled to said cooperative network site via said communication network; and

a consumer computer coupled to one of said manufacturer network site and retailer network site via said communication network,

wherein said cooperative network site is configured to transmit at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request made over said communication network from one of said manufacturer network site and retailer network site.

The examiner relies on the following references:

Sloane	5,918,211	Jun. 29, 1999 (filed May 30, 1996)
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Narasimhan et al. (Narasimhan)	6,237,145	May 22, 2001 (filed Aug. 14, 1996)
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Claims 50, 51, 60, 61, 70, 71, 80 and 81 stand rejected under 35 U.S.C. § 102(e) as anticipated by Sloane.

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Claims 52-59, 62-69, 72-79 and 82-89 stand rejected under 35 U.S.C. § 103 as unpatentable over Sloane in view of Narasimhan.<sup>1</sup>

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

At the outset, we note that while appellants devote eleven pages in the Third Supplemental Brief, filed December 23, 2002, to arguing a rejection under 35 U.S.C. § 112, first paragraph, there is no such rejection on appeal herein since the examiner has made no such rejection in the answer. Accordingly, we consider only the prior art rejections under 35 U.S.C. § 102(e) and § 103.

Independent claims 50, 60, 70 and 80 all stand rejected as being anticipated by Sloane.

Taking claim 50, as exemplary, the examiner applies Sloane as follows:

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<sup>1</sup>While claim 54 is included in the statement of rejection under 35 U.S.C. § 103, at page 5 of the answer, we note that the examiner includes this claim in the rejection under 35 U.S.C. § 102(e) in the explanation of the issues at page 2 of the answer. We will assume that the rejection of this claim is, in fact, under 35 U.S.C. § 103, as that is what the statement of rejection indicates.

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The "cooperative network site..." is said to be taught at column 7, lines 22-26, of Sloane. The "at least one of a manufacturer network site and a retailer network site coupled to said cooperative network site via said communication network" is said to be taught by Sloane at column 7, lines 13-17. The "consumer computer..." is said to be taught by Sloane at Figures 4 and 5, where the consumer computer is represented as the portable bar code scanning device. Finally, the wherein clause, "wherein said cooperative network site is configured to transmit at least one of said manufacturer incentives and retailer incentives to said consumer over said communication network, in response to a consumer request..." is said to be taught by Sloane at column 7, line 65 through column 8, lines 7, and at column 8, lines 44-48.

Appellants' response to this rejection appears in the Supplemental Appeal Brief, filed April 11, 2001.

Appellants argue that whereas the instant invention is directed to distributing product incentives to consumers over a communication network, including a consumer computer coupled to various network sites, Sloane is concerned with providing incentives to consumers at a point-of-purchase in a retail store.

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We do not find this argument to be persuasive. Clearly, the network over which the sender, or manufacturer, sends the incentives to the retailer is a "communication" network. While even appellants admit that the processing of incentives between a retailer (or product manufacturer) and a retailer computer/controller 12 is performed over a "communication" network (see Supplemental Appeal Brief of April 11, 2001-page 8), appellants argue that Sloane fails to disclose or suggest distributing product incentives to consumers over a communication network.

Again, we are not persuaded by this argument. While appellants may envision sending the incentives directly to consumers at their home computers, in this regard, the claims require only that there is a "consumer computer" coupled to one of the retailer or manufacturer network sites and that the incentives are transmitted to the consumer over the communication network and in response to a consumer request made over the network. It is our view that Sloane clearly teaches as much. As the examiner indicates, at page 4 of the answer, the "consumer computer" in Sloane may be the hand-held scanning device which the consumer carries through the store.

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First, we have already established that the transmissions in Sloane are performed over a "communication network."

Further, in Sloane, a sender of promotional information sends the information to the retailer computer/controller (column 7, lines 13-14). Thus, incentives are provided over a communication network. Then, the consumer is eventually given the promotion, or promotional price, on a given product through a wireless communication network, as the scanner (i.e., "consumer computer") offers the consumer the discount or promotion (note column 8, lines 1-7)<sup>2</sup>.

While one might argue that the promotion is not transmitted directly to the consumer computer in Sloane, the promotion is clearly transmitted, at least indirectly, to the consumer, and this is all that is required by the instant claims. Moreover, any promotion or discount offered in Sloane is clearly "in response to a consumer request." Not only does Sloane indicate in the Background section that it was known for consumers to

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<sup>2</sup>We note, further, the disclosure of Sloane, in the background section of the document, at column 2, lines 19-20, wherein it is disclosed that there were well known methods of issuing electronic coupons to consumers or promotions to consumers which include "consumer requested promotion/coupons through the use of their home computer and an online computer network."



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request coupons over the internet, even in Sloane's actual invention, a consumer first locates and scans a related product required for a promotion and then the discount is taken (see column 8, lines 45-49).

Having determined that the examiner has set forth a prima facie case of anticipation and that appellants have failed to overcome such case by any convincing argument, we will sustain the rejection of claims 50, 51, 60, 61, 70, 71, 80 and 81 under 35 U.S.C. § 102(e).

Turning now to the rejection of claims 52-59, 62-69, 72-79 and 82-89 under 35 U.S.C. § 103, the examiner cites Narasimhan (specifically, column 4, lines 62-65, and column 8, lines 4-13) as providing for the deficiency, in Sloane, of disclosing, as in claim 52, for example, "wherein, in response to a query from said consumer made over said communication network from said manufacturer network site, said cooperative network site transmits a geographically limited list of retailers honoring incentives from said manufacturer and corresponding incentive data to said consumer...."

It is the examiner's position that it would have been obvious to provide such a list of geographically limited retailers so as to give the consumer "the ability to customize

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and control his or her purchase preferences by location" (answer-page 5).

Appellants' Supplemental Appeal Brief, filed April 11, 2001, says nothing about this rejection based on Narasimhan, referring only to a rejection based on a patent to Allsop, together with Sloane. Similarly, neither appellants' Appeal Brief, filed March 2, 2001, nor the Third Supplemental Brief, filed December 23, 2002, says anything about this rejection. Accordingly, nothing therein is persuasive of any error on the examiner's part in rejecting the claims under 35 U.S.C. § 103 over Sloane and Narasimhan.

In fact, we have nothing responsive to the examiner's specific rejection under 35 U.S.C. § 103 until the Reply Brief, filed April 22, 2003, at which point appellants present no argument regarding the merits of the examiner's rejection, preferring, instead, to attack the examiner's rejection under 35 U.S.C. § 103, based on the combination of Sloane and Narasimhan, by attacking it procedurally. More particularly, appellants argue that this constitutes a new ground of rejection which is prohibited by 37 CFR 1.193 (a) (2).

We have reviewed the record of this case and it appears that the rejection under 35 U.S.C. § 103, based on Sloane and

Appeal No. 2004-1267  
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Narasimhan, is not a new ground of rejection as to claims 52, 53, 55-59, 62, 72 and 82, the rejection in the Answer appearing substantially the same as a rejection of those claims in Paper No. 45 (page 9), mailed September 23, 2002.

However, the rejection of claims 54, 63-69, 73-79 and 83-89 under 35 U.S.C. § 103, appearing in the answer, does constitute a new ground of rejection because the rejection of these claims on this ground does not appear in Paper No. 45.

Accordingly, we will summarily sustain the rejection of claims 52, 53, 55-59, 62, 72 and 82 under 35 U.S.C. § 103 because the examiner seems to have stated a reasonable case for a finding of obviousness, which has not been rebutted by appellants in any substantive manner. We note, however, that our affirmance of this rejection is pro forma, and not based on substantive arguments since appellants have presented no substantive arguments with regard to this rejection.

With regard to the rejection of claims 54, 63-69, 73-79 and 83-89 under 35 U.S.C. § 103, this is a new ground of rejection, not permitted under 37 CFR 1.193 (a)(2). Accordingly, with regard to the rejection of these claims, we remand the application to the examiner to either withdraw the rejection or reopen prosecution, giving appellants an opportunity to respond

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to the new ground of rejection if it is to be applied.

Since we have sustained the rejection of claims 50, 51, 60, 61, 70, 71, 80 and 81 under 35 U.S.C. § 102(e) and the rejection of claims 52, 53, 55-59, 62, 72, and 82 under 35 U.S.C. § 103, the examiner's decision is affirmed.

The application is also remanded to the examiner for action consistent with the reasoning herein with regard to the rejection of claims 54, 63-69, 73-79 and 83-89 under 35 U.S.C. § 103.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

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This application, by virtue of its "Special" status, requires an immediate action, MPEP 708.01 (8th ed., August, 2001).

AFFIRMED AND REMANDED

Enoch. K.

ERROL A. KRASS  
Administrative Patent Judge

*Michael R. Fleming*  
MICHAEL R. FLEMING

MICHAEL R. FLEMING /  
Administrative Patent Judge

JOSEPH L. DIMON

JOSEPH L. DIXON  
Administrative Patent Judge

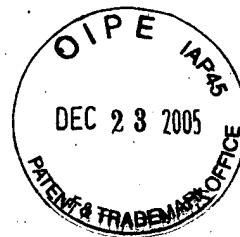
BOARD OF PATENT  
APPEALS AND  
INTERFERENCES

EK/RWK

—  
Appeal No. 2004-1267  
Application No. 08/873,974

NEIFELD IP LAW, PC  
2001 JEFFERSON DAVIS HIGHWAY  
ARLINGTON, VA 22202

Attachment 3



The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 53

UNITED STATES PATENT AND TRADEMARK OFFICE

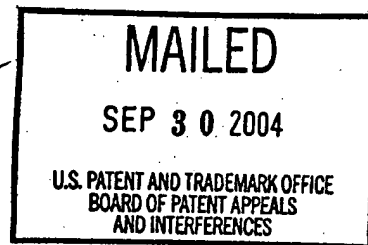
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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte MICHAEL C. SCROGGIE, DAVID A. ROCHON,  
DAVID W. BANKER and WILL GARDENSWARTZ

Appeal No. 2004-1267 ✓  
Application No. 08/873,974 ✓

ON BRIEF



Before KRASS, FLEMING and DIXON, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellants request rehearing of our decision of July 29, 2004, wherein we affirmed the examiner's decision rejecting claims 52, 53, 55-59, 62, 72 and 82 under 35 U.S.C. § 103.

Initially, appellants argue that we have not decided an issue involving a rejection under 35 U.S.C. § 112, even though that rejection had been withdrawn by the examiner and was not on

Attachment 3  
Doc CAT34SCROUS-041001

In re SCROGGIE  
Appeal No. 05-1164  
000519

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Appeal No. 2004-1267  
Application No. 08/873,974

appeal before us. Appellants take the position that the rejection was, in fact, on appeal because they had appealed from the examiner's rejection of the claims under 35 U.S.C. § 112 and that we must decide the propriety of this rejection even in the face of the examiner's withdrawal of such rejection.

We disagree. Once an examiner withdraws a rejection of claims, at or before the time of the answer, that rejection is no longer before us on appeal and we will not issue an opinion as to the propriety of a now-theoretical rejection.

Appellants are concerned that since there was a suggestion of reopening prosecution in our decision<sup>1</sup>, a lack of a decision by us regarding the § 112 rejection might leave appellants open to re-imposition of that rejection by the examiner.

If, and when, the examiner deems it appropriate to make a rejection under 35 U.S.C. § 112, and such rejection is appealed to us, we will treat that rejection. But, at least at the time of the answer, the examiner no longer believed a rejection under 35 U.S.C. § 112 to be proper and chose not to make it. The Board would find itself in an awkward position attempting to decide an

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<sup>1</sup>We indicated in the decision, at page 9, that the examiner's rejection of claims 54, 63-69, 73-79, and 83-89 under 35 U.S.C. § 103 was a new ground of rejection, not permitted under 37 CFR 1.193 (a) (2), and remanded to the examiner to either withdraw the rejection or reopen prosecution.



—  
Appeal No. 2004-1267  
Application No. 08/873,974

issue on which both appellants and the examiner are in apparent agreement, viz., that a rejection under 35 U.S.C. § 112 was not improper. Where there is no controversy, there is no need for the Board, or any tribunal, to make a decision.

Accordingly, we decline appellants' invitation to render a decision on whether claims are proper, within the meaning of 35 U.S.C. § 112.

Appellants further argue that we misapprehended the claim limitation, "in response to a consumer request..." and the reasoning in support thereof in the brief filed July 10, 2001.

Part of the problem arises from multiple filings, by appellants, of various briefs and supplemental briefs, and attempting to incorporate by reference, into the arguments, all of these briefs. Thus, rather than including all of appellants' arguments in a single brief and/or a brief and possibly one reply brief, the record is rife with arguments scattered throughout several papers.

In any event, our decision did treat the "in response to a consumer request..." limitation of the claims, by indicating, at page 6 of our decision, that any promotion or discount offered in Sloane is clearly "in response to a consumer request." The reason is explained in the paragraph bridging pages 6-7 of the

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Application No. 08/873,974

decision. Thereat, we indicated that the background section of Sloane disclosed that it was known for consumers to request coupons over the internet (see column 2, lines 18-21). Further, we noted, at page 7 of the decision, that even in Sloane's actual invention, a consumer first locates and scans a related product required for a promotion (see column 8, lines 45-49). Accordingly, it is clear that any promotion, or discount, issued is "in response to a consumer request..." as claimed.

Thus, it is clear that, contrary to appellants' assertions, we did not ignore the "in response to a consumer request..." limitation of the claims.

Appellants further argue that we overlooked the brief filed July 10, 2001 and the reasoning therein relative to the inapplicability of the Narasimhan reference. We have reviewed the second supplemental brief, filed July 10, 2001, but find nothing therein to cause us to modify our decision. In that document, appellants simply point out that "there is no evidence supporting the examiner's rationale that transmitting a geographically limited list of retailers honoring incentives in response to a query is a more efficient way of obtaining desired information;" and that the examiner's conclusion of obviousness in combining the teachings of Narasimhan and Sloane "is vague" and "unsupported" by any evidence.

Appeal No. 2004-1267  
Application No. 08/873,974


We find appellants' arguments insufficient to overcome the examiner's reasonable explanation that Narasimhan suggests, at column 4, lines 62-65, and column 8, lines 4-13, providing for certain geographic-specific promotions to consumers. Again, appellants do not appear to have addressed the specific teachings of Narasimhan, as pointed out by the examiner. Appellants' mere assertion that there is no evidence supporting the examiner's rationale, or that the examiner's conclusions are "vague," fails to point out the error in the examiner's position that Narasimhan clearly suggests using geographic-specific promotions.


Having responded to each and every assertion made by appellants in the Request for Rehearing, filed August 6, 2004, and finding nothing persuasive therein, we decline to make any modification to our decision of July 29, 2004. Appellants' request for rehearing is granted to the extent that we have reviewed and reconsidered our decision and the evidence of record, but the request is denied with respect to making any changes therein.


Appeal No. 2004-1267  
Application No. 08/873,974

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

DENIED

  
ERROL A. KRASS  
Administrative Patent Judge

  
MICHAEL R. FLEMING  
Administrative Patent Judge

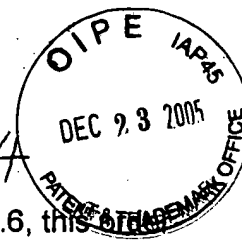
  
JOSEPH L. DIXON  
Administrative Patent Judge

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—  
Appeal No. 2004-1267  
Application No. 08/873,974

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2001 JEFFERSON DAVIS HIGHWAY  
ARLINGTON, VA 22202



No Date Set

Attachment 4

NOTE: Pursuant to Fed. Cir. R. 47.6, this order  
is not citable as precedent. It is a public order.

## United States Court of Appeals for the Federal Circuit

05-1164 ✓  
(Serial No. 08/873,974) ✓

IN RE MICHAEL C. SCROGGIE, DAVID A. ROCHON, DAVID W. BANKER,  
and WILL GARDENSWARTZ (Real Party in Interest Catalina Marketing Corporation)

ON MOTION

### ORDER

Upon consideration of the unopposed motion of Michael C. Scroggie et al. to  
remand this case to the Patent and Trademark Office for further proceedings,

IT IS ORDERED THAT:

- (1) The motion is granted.
- (2) Each side shall bear its own costs.

FOR THE COURT

MAR - 9 2005

Date

Jan Horbaly  
Clerk

cc: Robert G. Crockett, Esq.  
John M. Whealan, Esq.

s5

MAR - 9 2005

ISSUED AS A MANDATE : \_\_\_\_\_

FILED  
U.S. COURT OF APPEALS FOR  
THE FEDERAL CIRCUIT

MAR - 9 2005

JAN HORBALY  
CLERK

Attachment 4

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Ord - CAT34SCROUS - 050311

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